

1 Juanita R. Brooks (CA SBN 75934)  
brooks@fr.com  
2 Roger A. Denning (CA SBN 228998)  
denning@fr.com  
3 Jason W. Wolff (CA SBN 215819)  
wolff@fr.com  
4 John-Paul Fryckman (CA SBN 317591)  
fryckman@fr.com  
5 K. Nicole Williams (CA291900)  
nwilliams@fr.com  
6 FISH & RICHARDSON P.C.  
12860 El Camino Real, Suite 400  
7 San Diego, CA 92130  
Phone: (858) 678-5070  
8 Fax: (858) 678-5099

D. Stuart Bartow (SBN 233107)  
Email: DSBartow@duanemorris.com  
**DUANE MORRIS LLP**  
2475 Hanover Street  
Palo Alto, CA 94304-1194  
Tel.: 650.847.4150  
Fax: 650.847.4151

*Additional counsel listed on signature page*

*Attorneys for Defendant*  
SONICWALL, INC.

**9** Additional counsel listed on signature page

0 | *Attorneys for Plaintiff*  
FINJAN LLC

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

.5 FINJAN LLC, a Delaware Corporation,

Case No.: 5:17-cv-04467-BLF (VKD)

6 Plaintiff,

**STIPULATION AND [PROPOSED] ORDER  
RE: SUBMISSION OF BRIEFS RELATING  
TO COLLATERAL ESTOPPEL ISSUES FOR  
THE '844, '780, AND '494 PATENTS**

-7

8 SONICWALL, INC., a Delaware Corporation,

Judge: Hon. Beth Labson Freeman  
Dept: Courtroom 3, Fifth Floor

1 Plaintiff Finjan, LLC (“Finjan”) and Defendant SonicWall, Inc. (“SonicWall”)  
2 (collectively, the “Parties”), respectfully submit this Stipulation and [Proposed] Order Re:  
3 Submission of Briefs Relating to Collateral Estoppel Issues for the ’844, ’780, and ’494 Patents.

4 WHEREAS, in the matter of *Finjan, LLC v. Cisco Systems, Inc.*, No. 5:17-cv-00072-BLF-  
5 SVK (N.D. Cal.) (“Cisco Action”), Cisco Systems, Inc. (“Cisco”) and Finjan filed the following  
6 motion and briefs: Cisco’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents  
7 Based on Collateral Estoppel (Dkt. No. 759) (attached hereto as Ex. A); Finjan’s Opposition to  
8 Cisco’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral  
9 Estoppel (Dkt. No. 762) (attached hereto as Ex. B); and Cisco’s Reply in Support of its Motion for  
10 Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral Estoppel (Dkt. No.  
11 764) (attached hereto as Ex. C) (collectively “Collateral Estoppel Briefs”).

12 WHEREAS, the Parties respectfully request that the Collateral Estoppel Briefs filed in the  
13 Cisco Action be deemed filed in this case.

14 WHEREAS, the Parties further request that Cisco’s motion and reply brief (Exs. A and C  
15 hereto) and the relief requested therein be deemed filed by SonicWall in this case and Finjan’s  
16 opposition (Ex. B hereto) be deemed filed by Finjan in this case.

17 WHEREAS, with the Collateral Estoppel Briefs deemed as filed in this case, the Parties  
18 respectfully submit that the Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents  
19 Based on Collateral Estoppel is ripe in this case and ready for resolution by the Court.

20 NOW, THEREFORE, the Parties respectfully request that the Court issue the proposed  
21 order consistent with the above jointly submitted herewith.

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1 Dated: June 21, 2021

2 By: /s/ Juanita R. Brooks  
3 Juanita R. Brooks (CA SBN 75934)  
4 brooks@fr.com  
5 Roger A. Denning (CA SBN 228998)  
denning@fr.com  
6 Jason W. Wolff (CA SBN 215819)  
wolff@fr.com  
7 John-Paul Fryckman (CA SBN 317591)  
fryckman@fr.com  
8 K. Nicole Williams (CA291900)  
nwilliams@fr.com  
9 FISH & RICHARDSON P.C.  
12860 El Camino Real, Suite 400  
San Diego, CA 92130  
Telephone: (858) 678-5070  
10 Facsimile: (858) 678-5099  
11 Proshanto Mukherji (*Pro Hac Vice*)  
mukherji@fr.com  
12 FISH & RICHARDSON P.C.  
One Marina Park Drive  
Boston, MA 02210  
13 Telephone: (617) 542-5070  
14 Robert Courtney (CA SNB 248392)  
courtney@fr.com  
15 FISH & RICHARDSON P.C.  
3200 RBC Plaza  
60 South Sixth Street  
16 Minneapolis, MN 55402  
Telephone: (612) 335-5070  
17  
**18 Attorneys for Plaintiff**  
19 FINJAN LLC  
20  
21  
22  
23  
24  
25  
26  
27  
28

By: /s/ Matthew C. Gaudet

D. Stuart Bartow (SBN 233107)  
Email: DSBarlow@duanemorris.com  
DUANE MORRIS LLP  
2475 Hanover Street  
Palo Alto, CA 94304-1194  
Tel.: 650.847.4150  
Fax: 650.847.4151

Matthew C. Gaudet (Admitted *Pro Hac Vice*)  
mcgaudet@duanemorris.com  
David C. Dotson (Admitted *Pro Hac Vice*)  
dcdotson@duanemorris.com  
Robin McGrath  
rlmcgrath@duanemorris.com  
Jennifer H. Forte (Admitted *Pro Hac Vice*)  
jhforte@duanemorris.com  
Alice E. Snedeker  
aesnedeker@duanemorris.com  
DUANE MORRIS LLP  
1075 Peachtree NE, Suite 2000  
Atlanta, GA 30309-3929  
Telephone: 404.253.6900

Joseph A. Powers (Admitted *Pro Hac Vice*)  
Email: japowers@duanemorris.com  
Jarrad M. Gunther (Admitted *Pro Hac Vice*)  
Email: jmgunther@duanemorris.com  
DUANE MORRIS LLP  
30 South 17th Street  
Philadelphia, PA 19103  
Telephone: 215.979.1000

**Attorneys for Defendant**  
SONICWALL, INC.

1                   **CONCURRENCE IN FILING**

2                   I, Matthew C. Gaudet, hereby attest that the concurrence to the filing of this document has  
3 been obtained from each signatory hereto.

4                   */s/ Matthew C. Gaudet*

5                   Matthew C. Gaudet

6                   **CERTIFICATE OF SERVICE**

7                   The undersigned hereby certifies that a true and correct copy of the above and foregoing  
8 document has been served on June 21, 2021, to all counsel of record who are deemed to have  
9 consented to electronic service via the Court's CM/ECF system.

10                  */s/ Matthew C. Gaudet*

11                  Matthew C. Gaudet

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# EXHIBIT A

1 D. Stuart Bartow (CA SBN 233107)  
2 dsbartow@duanemorris.com  
3 Nicole E. Grigg (CA SBN 307733)  
4 negrigg@duanemorris.com  
DUANE MORRIS LLP  
2475 Hanover Street  
Palo Alto, CA 94304-1194  
Telephone: 650.847.4146  
Facsimile: 650.847.4151

6  
7 *Additional attorneys on signature page*

8 Attorneys for Defendant  
9 CISCO SYSTEMS, INC.

10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA,  
12 (SAN JOSE DIVISION)

13 FINJAN LLC, a Delaware Limited Liability  
14 Company,

15 Plaintiff,

16 ,  
17 CISCO SYSTEMS, INC., a California  
18 Corporation,

19 Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**CISCO SYSTEMS, INC.'S MOTION FOR  
JUDGMENT OF INVALIDITY OF THE  
'844, '780, AND '494 PATENTS BASED  
ON COLLATERAL ESTOPPEL**

1       Defendant Cisco Systems, Inc. (“Cisco”) seeks judgment that the ’844 and ’780 Patents are  
 2 invalid based on the ESET Order and that the ’494 Patent is invalid based on the same “issue”  
 3 resolved against Finjan in the ESET Order. For the ’494 Patent, Federal Circuit law is clear that  
 4 the ESET Order applies with equal force to patents whose intrinsic record presents the same  
 5 “issue” that led to the invalidity ruling. The ’494 Patent satisfies this test because it is a  
 6 continuation of a patent found invalid in the ESET Order (the ’086 Patent), with the same  
 7 “Downloadable” term, the same specification, and the same intrinsic record on which the ESET  
 8 Order relied (in fact, the same intrinsic record on which the ESET Order relied to invalidate all  
 9 five related patents). Based on the reasoning of the ESET Order and the collective treatment of  
 10 those five patents, the ’494 Patent unquestionably would have been found invalid in that case had  
 11 Finjan asserted it there. The Federal Circuit case law confirms that this is a distinction without a  
 12 difference; the patent holder is estopped with respect to all patents that present the same “issue.”  
 13 The law is equally clear that Cisco’s prior positions in this case do not protect Finjan from the  
 14 impact of the ESET Order on the ’494 Patent. Collateral estoppel renders the ’494 Patent invalid,  
 15 regardless of what has previously occurred in this case.

16 **I. BACKGROUND**

17       On March 23, 2021, Judge Bencivengo issued a summary judgment order invalidating the  
 18 ’844 and ’780 Patents, along with U.S. Patent Nos. 8,079,086 (“’086 Patent”); 9,189,621 (“’621  
 19 Patent”); and 9,219,755 (“’755 Patent”) (collectively, “Invalidated Patents”), as indefinite based  
 20 on the term “Downloadable.” *Finjan, Inc. v. ESET, LLC*, Case No. 3:17-cv-0183-CAB-BGS, Dkt.  
 21 No. 864 (“ESET Order,” attached as Ex. A) at 8. Judge Bencivengo based her decision on her  
 22 construction of “Downloadable” as “a small executable or interpretable application program which  
 23 is downloaded from a source computer and run on a destination computer,” which is the express  
 24 definition set forth in U.S. Patent Nos. 6,167,520 (“’520 Patent”) and 6,480,962 (“’962 Patent”)  
 25 that the Invalidated Patents incorporate by reference. *Id.* at 4-5.

26       The ’494 Patent is a direct continuation (with the identical specification) of the ’086  
 27 Patent, which the ESET Order invalidated. Dkt. No. 1-5 (’494 Patent) at 1:7-11. Every claim of  
 28 the ’494 Patent contains the now-indefinite term “Downloadable.” Just like each of the

1 Invalidated Patents, the '494 Patent incorporates by reference the subject matter of the '520 and  
 2 '962 Patents that served the basis of the ESET Court's indefiniteness decision. *Id.* at 1:43-55.

## 3 **II. GOVERNING LAW FOR COLLATERAL ESTOPPEL**

4 "To foreclose relitigation of an issue under collateral estoppel, four conditions must be  
 5 met: '(1) the issue at stake was identical in both proceedings; (2) the issue was actually litigated  
 6 and decided in the prior proceedings; (3) there was a full and fair opportunity to litigate the issue;  
 7 and (4) the issue was necessary to decide the merits.'" *Arista Networks, Inc. v. Cisco Sys., Inc.*,  
 8 No. 16-CV-00923-BLF, 2017 WL 6102804, at \*11 (N.D. Cal. 10/10/17) (quoting *Oyeniran v.  
 9 Holder*, 672 F.3d 800, 806 (9th Cir. 2012)). Under Ninth Circuit law, a summary judgment order  
 10 satisfies the requirement of a "final judgment" for the purpose of collateral estoppel, regardless of  
 11 whether it is appealable yet. *Abbott Diabetes Care Inc. v. Roche Diagnostics Corp.*, C04-  
 12 02123MJJ, 2007 WL 1239220, at \*12 (N.D. Cal. 4/27/07) ("Under Ninth Circuit law, to be 'final'  
 13 for collateral estoppel purposes, a decision need not possess 'finality' in the sense of 28 U.S.C.  
 14 § 1291. Instead, a final judgment for purposes of collateral estoppel is any prior adjudication of an  
 15 issue in another action that is determined to be 'sufficiently firm' to be accorded preclusive  
 16 effect." (internal citations omitted)). Even "the pendency of an appeal in the Federal Circuit 'does  
 17 not suspend the operation of an otherwise final judgment as *res judicata* or collateral estoppel.'"  
 18 *Gonzalez v. Tagged, Inc.*, 16-cv-00574-YGR, 2016 WL 3257734, at \*2 (N.D. Cal. 6/14/16)  
 19 (quoting *Convergence Corp. v. Videomedia*, 539 F. Supp. 760, 762 (N.D. Cal. 1981)).

## 20 **III. THE '844 AND '780 PATENTS ARE INVALID**

21 The ESET Order satisfies the four elements for collateral estoppel for the '844 and '780  
 22 Patents and already qualifies as a "final judgment" for purposes of collateral estoppel. *Id.* This  
 23 Court therefore should enter judgment of invalidity.

## 24 **IV. THE '494 PATENT IS ALSO INVALID**

25 The ESET Order also satisfies the four collateral estoppel elements for "Downloadable" in  
 26 the '494 Patent. The first element ("identical issue") is met for the reasons discussed below. The  
 27 ESET Order on its face confirms the last three elements: the issue (whether the claim term  
 28 "Downloadable" is indefinite on this intrinsic record) was litigated and decided in the ESET

1 Order; Finjan had a “full and fair opportunity” to litigate it; and the issue was necessary to decide  
 2 the merits of invalidity. Finjan’s arguments about why it disagrees with the ESET Order are  
 3 irrelevant; the “full and fair opportunity” prong is a limited inquiry. *Stevenson v. Sears, Roebuck*  
 4 & Co., 713 F.2d 705, 709 (Fed. Cir. 1983) (“it is clear from the case law that has developed since  
 5 *Blonder-Tongue* that an inappropriate inquiry is whether the prior finding of invalidity was  
 6 correct; instead, the court is only to decide whether the patentee had a full and fair opportunity to  
 7 litigate the validity of his patent in the prior unsuccessful suit”).

8       **A. The ’494 Patent Is Invalid Based on the “Identical Issue” as the ESET Order**

9           Although the ’494 Patent is not referenced in the ESET Order (because it was not asserted  
 10 against ESET), the same indefinite term (“Downloadable”) appears in every claim of the ’494  
 11 Patent, and the ’494 Patent has the same intrinsic record on which the ESET Order relied. In other  
 12 words, every basis for the ESET Order exists and applies with equal force to the ’494 Patent. To  
 13 bring this issue into clear focus, if Finjan had asserted the ’494 Patent in the ESET case, the ESET  
 14 Order already would have held the ’494 Patent invalid.

15           The *Blonder-Tongue* principle therefore applies equally to the ’494 Patent. *Ohio Willow*  
 16 *Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (“Our precedent does not limit  
 17 collateral estoppel to patent claims that are identical. Rather, it is the identity of the *issues* that  
 18 were litigated that determines whether collateral estoppel should apply.”). In cases applying the  
 19 “same issue” principle from *Ohio Willow*, the Federal Circuit has used collateral estoppel to  
 20 invalidate a related patent (i.e., a *different* patent than the patent on which collateral estoppel  
 21 arises) as a matter of law, where the “issue” was the same -- and the Federal Circuit did so even  
 22 where the issue was raised for the first time on appeal:

23           It is undisputed that the claims at issue in the two appeals use the term “aseptic” (or its  
 24 related variation “aseptically disinfecting”) in a similar fashion. *Compare* ’468 patent, col.  
 25 26 l. 20 . . . *with* ’013 patent, col. 16 ll. 36-62 . . . More critically, the two patents also  
 26 provide identical lexicography for the term ‘aseptic’ in their specifications... Neither party  
 27 has pointed to any material difference between the two patents or their prosecution  
 28 histories that would give rise to claim construction issues in this appeal different from

1           those raised in the prior appeal. Accordingly, Steuben Foods has had a full and fair  
 2           opportunity to litigate the issue of claim construction during the prior appeal.

3         *Nestlé USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1351-52 (Fed. Cir. 2018). *See also Papst*  
 4         *Licensing GMBH & Co. v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019)  
 5         (“The ’144 Patent Aytac Decision resolved against Papst the claim construction and Aytac-  
 6         teaching issues now before us [on the ’437 Patent], and those resolutions were essential to the  
 7         Board’s decision. . . . Issue preclusion therefore applies . . . .”)

8           Any difference in surrounding claim language is irrelevant; it is the identity of the “issue”  
 9         (i.e., whether the term “Downloadable” is indefinite based on the ESET Court’s claim  
 10         construction) that is controlling. *Arunachalam v. Presidio Bank*, 801 F. App’x 750, 752-53 (Fed.  
 11         Cir. 2020) (“As to the first condition for applying collateral estoppel (identical issue), we find that  
 12         the remaining claims in the ’500, ’492, and ’158 patents all rely on at least one of the claim terms  
 13         found indefinite, not enabled, or failing written description by *JPMorgan* and that these remaining  
 14         claims do not significantly alter the analysis of those terms.”).

15           **B. The Details of the Earlier Proceedings In This Case Are Irrelevant**

16         Finjan seeks to avoid the application of collateral estoppel to the ’494 Patent based on  
 17         Cisco’s stipulation to a different construction of the term “Downloadable” in this case, but that  
 18         stipulation is no more relevant to the invalidity of the ’494 Patent than it is to the ’844 and ’780  
 19         Patents. In applying collateral estoppel in this context, a court simply determines whether the 4-  
 20         factor test is met, and does not revisit whether it agrees with the other court’s ultimate decision on  
 21         invalidity or the sub-issues that led to the invalidity finding. *Crossroads Sys. (Tex.), Inc. v. Dot*  
 22         *Hill Sys. Corp.*, 2006 WL 1544621, at \*5 (W.D. Tex. 5/31/06) (“the overwhelming weight of  
 23         authority suggests that the ‘issue’ that is to be given issue-preclusive effect to a judgment in the  
 24         patent context is the ultimate determination on patent validity itself, not the sub-issues or the  
 25         individual pieces of evidence and arguments that may have been necessary to support the validity  
 26         determination”). Under *Ohio Willow*, the “issue” for all three patents is the same, i.e., the  
 27         invalidity of the patents arising from the indefiniteness of the term “Downloadable” based on the  
 28         same intrinsic record. Just like the ’844 and ’780 Patents, the earlier stipulation in this case on the

1 '494 Patent is legally irrelevant. Indeed, the doctrine would apply even if Cisco had previously  
 2 lost the issue of validity at trial. *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1579-80 Fed.  
 3 Cir. 1994).

4 Cisco's stipulation on the underlying issue of the construction of "Downloadable" cannot  
 5 change the outcome that the '494 Patent is now invalid. Regardless of what happened earlier in  
 6 this case, the doctrine of collateral estoppel does not allow the '494 Patent to be invalid when  
 7 asserted against the rest of the world, but still valid against Cisco. Indeed, in *Mendenhall*, the  
 8 Federal Circuit reversed a district court's refusal to apply collateral estoppel where the defendant  
 9 seeking to apply the invalidity ruling from another case (i.e., the party situated like Cisco here)  
 10 had itself *already tried and lost* the issue of invalidity, and then after that trial a different court  
 11 found the patent to be invalid:

12 [O]ur precedent holds that the defense of collateral estoppel based on a final judgment of  
 13 patent invalidity in another suit can "be timely made at any stage of the affected  
 14 proceedings." . . . [A]ppellants' defense of collateral estoppel is not untimely.

15 *Id.* at 1579-80. A district court has rejected the materially identical argument that Finjan makes:

16 Quest also contends that collateral estoppel should not apply because A.Hak has stipulated  
 17 to definitions of certain claim terms that are different than the constructions applied by  
 18 Judge Robinson. That, however, is an issue of claim construction that does not alter the  
 19 preclusive effect of Judge Robinson's express findings that specific patent claims at issue  
 20 in this action are invalid. The Court finds that collateral estoppel applies . . . .

21 *Quest Integrity USA, LLC v. A.Hak Indus. Servs. US, LLC*, No. C14-1971-RAJ, 2017 U.S. Dist.  
 22 LEXIS 119821, at \*10-11 (W.D. Wash. 7/31/17), vacated on other grounds by agreement of the  
 23 parties, 2:14-cv-01971 RAJ, 2019 U.S. Dist. LEXIS 79571, at \*1 (W.D. Wash. 5/10/19). The  
 24 Federal Circuit has likewise repeatedly held that a defense of collateral estoppel based on a final  
 25 judgment of patent invalidity in another suit can "be timely made at any stage of the affected  
 26 proceedings." *Dana Corp. v. NOK, Inc.*, 882 F.2d 505, 507 (Fed. Cir. 1989). See also *Thompson-*  
*27 Hayward Chem. Co. v. Rohm & Hass Co.*, 745 F.2d 27, 32-33 (Fed. Cir. 1984) (applying estoppel  
 28 to invalidity judgment on appeal even though infringer did not challenge validity at trial).

1 Dated: April 19, 2021

Respectfully Submitted,

2 DUANE MORRIS LLP

3 By: /s/ Nicole E. Grigg

4 D. Stuart Bartow (CA SBN 233107)

5 dsbartow@duanemorris.com

6 Nicole E. Grigg (CA SBN 307733)

7 negrigg@duanemorris.com

2475 Hanover Street

8 Palo Alto, CA 94304-1194

Telephone: 650.847.4146

Facsimile: 650.847.4151

9 L. Norwood Jameson (admitted *pro hac vice*)

10 Email: wjameson@duanemorris.com

11 Matthew C. Gaudet (admitted *pro hac vice*)

12 Email: mcgaudet@duanemorris.com

13 Robin L. McGrath (admitted *pro hac vice*)

14 Email: rlmcgrath@duanemorris.com

15 David C. Dotson (admitted *pro hac vice*)

16 Email: dcDotson@duanemorris.com

17 John R. Gibson (admitted *pro hac vice*)

18 Email: jrgibson@duanemorris.com

19 Jennifer H. Forte (admitted *pro hac vice*)

20 Email: jhforte@duanemorris.com

21 Alice E. Snedeker (admitted *pro hac vice*)

22 Email: aesnedeker@duanemorris.com

23 1075 Peachtree Street, Ste. 2000

24 Atlanta, GA 30309

Telephone: 404.253.6900

Facsimile: 404.253.6901

25 Joseph A. Powers (admitted *pro hac vice*)

26 Email: japowers@duanemorris.com

27 Jarrad M. Gunther (admitted *pro hac vice*)

28 Email: jmgunther@duanemorris.com

30 South 17th Street

Philadelphia, PA 19103

Telephone: 215.979.1000

Facsimile: 215.979.1020

25 Attorneys for Defendant

26 CISCO SYSTEMS, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 19, 2021 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Nicole E. Grigg  
Nicole E. Grigg

**[PROPOSED] ORDER**

Upon consideration of all pleadings, papers, and arguments submitted in support of and opposition to Defendant Cisco Systems, Inc.’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral Estoppel (“Cisco’s Motion”), and good cause appearing therefor, the Court hereby GRANTS Cisco’s Motion and enters judgment that the ’844, ’780, and ’494 Patents are invalid for the reasons set forth in Cisco’s Motion.

Dated:

---

Hon. Beth Labson Freeman  
United States District Court Judge

# Exhibit A

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability  
and ESET SPOL. S.R.O., a Slovak  
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**ORDER ON DEFENDANTS'  
RENEWED MOTION FOR  
SUMMARY JUDGMENT OF  
INDEFINITENESS  
[Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

**I. Background**

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a

1 “Downloadable” based on the Court’s construction of that term, the Court denied the  
 2 motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would  
 3 establish what was generally understood in the art in 1997 as a “Downloadable” and such  
 4 testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

5 A jury trial commenced in this case on March 10, 2020. After three trial days the  
 6 Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial  
 7 due to the COVID-19 pandemic and the issuance of the State of California’s stay-home  
 8 order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and  
 9 backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

10 Having heard testimony from Finjan’s expert during the vacated trial on this issue,  
 11 however, the Court permitted ESET to renew this motion in consideration of the testimony  
 12 that was taken. Although Finjan’s patents have been the subject of much litigation, and  
 13 the term “Downloadable” has been construed by other courts, the issue raised in ESET’s  
 14 current motion does not appear to have been addressed by any prior constructions.

15 Finjan is the owner of a large family tree of patents for security systems and methods  
 16 of detecting malware in computer programs. Finjan has litigated many of their patents,  
 17 including some of the patents at-issue in this motion, in other district courts. Many have  
 18 also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The  
 19 Federal Circuit has issued at least nine opinions, precedential and non-precedential, on  
 20 appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders  
 21 or opinions discuss how earlier references incorporated into the patents at-issue inform the  
 22 construction of the term “Downloadable.”

## 23       **II.     The Construction of “Downloadable”**

24       In 2017, Finjan filed this litigation against defendants ESET asserting infringement  
 25 of the patents at-issue, and United States Patent No. 7,975,305.<sup>1</sup> Finjan claims priority for  
 26

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27  
 28<sup>1</sup> The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

the patents at-issue back to an application filed on November 8, 1996, Provisional Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and method for protecting computers from hostile Downloadables,” described as executable application programs automatically downloaded from a source computer and run on the destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term “Downloadable” is presented as a capitalized term in the provisional application and all the patents at-issue, signaling it is a specifically defined term. The definition of “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued patents. The explicit definitions include:

- “applets” (little applications) described in the 1990s as small interpreted or executable programs. *See* Provisional Application 60/030639 (filed November 8, 1996) [*Id.* at 5-6.]
- “Downloadables (i.e., applets)” as “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer,” in conformity with the original provisional application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18, 2000).
- “an executable application program which is downloaded from a source computer and run on a destination computer” (without “i.e., applet,” “small” or “interpretable” included in the definition but using applets and interpretable programs as examples of a “Downloadable” and incorporating the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col. 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60 (filed March 30, 2000).

Other district courts have determined that “Downloadable” lacked ordinary meaning when the patents were filed and construed it as “an executable application program which is downloaded from a source computer and run on a destination computer,” applying the

1 explicit definition from the ‘194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the  
 2 term was not amenable to plain and ordinary meaning and the patent applicant intended to  
 3 act as the lexicographer of this term, therefore the specification definition controls).] None  
 4 of these orders, however, discussed the significance of the ‘520 patent’s definition  
 5 incorporated into the ‘194 patent and its continuations. One district court, without  
 6 explanation, applied the broader definition from the ‘194 patent specification to the  
 7 construction of the term “Downloadable” in the ‘962 patent as “the same” definition [id.,  
 8 at 3, fn. 4], disregarding the fact the ‘962 patent explicitly defines “Downloadable” as “a  
 9 *small* executable or interpretable application program which is downloaded from a source  
 10 computer and run on a destination computer.” *See U.S. Patent No. 6,480,962, at Col. 1:39-*  
 11 *41 (emphasis added).*

12 Incorporation by reference provides a method for integrating material from various  
 13 documents into a host document by citing such material in a manner that makes clear that  
 14 the material is effectively part of the host document as if it were explicitly contained  
 15 therein. *See Trustees of Columbia Univ. v. Symantec, 811 F.3d 1359, 1365-66 (Fed. Cir.*  
 16 *2016) (citing Advanced Display Sys. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir.*  
 17 *2000) (provisional applications incorporated by reference are effectively part of the*  
 18 *specification as though it was explicitly contained therein.)). By incorporating the earlier*  
 19 *definition of “Downloadable” from the ‘520 Patent into the ‘194 Patent and subsequent*  
 20 *continuations (including the patents at-issue), the scope of the term is limited to “small*  
 21 *executable or interpretable application programs,” and not *all* executable application*  
 22 *programs (emphasis added). See Symantec, 811 F.3d at 1365 (rejecting a broad*  
 23 *interpretation of a claim term in part because a provisional application incorporated by*  
 24 *reference the same term more narrowly defined.) Inconsistent language used later cannot*  
 25 *support a broad claim construction when the explicit definition is incorporated from earlier*  
 26 *patents in the family tree.*

27 In this case, the Court concluded that based on its incorporation by reference in all  
 28 the patents at-issue, the explicit definition of “Downloadables” from the ‘520 patent and

1 the ‘962 patent, which is supported by the examples provided in the specification, is the  
 2 proper construction of “Downloadables” – “a small executable or interpretable application  
 3 program which is downloaded from a source computer and run on a destination computer.”  
 4 [Doc. No. 195.]

### 5 **III. The Indefiniteness Determination**

6 The Court’s claim construction, not unexpectedly, resulted in the present dispute as  
 7 to the scope of the modifier “small.” ESET argues that “small” is a term of degree with  
 8 no technical meaning or defined boundaries and there is insufficient information in the  
 9 intrinsic record for a skilled artisan to have clear notice of what constitutes a “small  
 10 executable or interpretable application program.” They further argue that this is  
 11 demonstrated by the inability of Finjan’s experts to come to a consistent opinion as to what  
 12 objective boundaries constitute a small application program. [806-1, at 5, 17.]

13 The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the  
 14 “specification shall conclude with one or more claims particularly pointing out and  
 15 distinctly claiming the subject matter which the applicant regards as his invention.” The  
 16 definiteness requirement focuses on whether “a patent’s claims, viewed in light of the  
 17 specification and prosecution history inform those skilled in the art about the scope of the  
 18 invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.  
 19 898, 910 (2014). The inquiry “trains on the understanding of a skilled artisan at the time  
 20 of the patent application.” *Id.* at 911.

21 Terms of degree must provide sufficient certainty to one of skill in the art to afford  
 22 clear notice of what is claimed and what is still open to the public. *See Biosig Instruments,*  
*Inc. v. Nautilus, Inc.*, 738 F.3d 1374, 1378 (Fed. Cir. 2015) (“When a ‘word of degree’ is  
 24 used, the court must determine whether the patent provides ‘some standard for measuring  
 25 that degree.’”); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)  
 26 (the definiteness standard must allow for a modicum of uncertainty but must also require  
 27 clear notice of what is claimed thereby apprising the public of what is still open to them).

1 Finjan’s contention that the claim term “Downloadable” cannot be indefinite simply  
 2 because the Court was able to construe it by adopting the explicit definition provided by  
 3 the inventor in the ‘520 patent fails to address the issue raised by ESET. A defined term is  
 4 still indefinite if a person of ordinary skill in the art cannot translate the definition into  
 5 meaningfully precise claim scope. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d  
 6 1244, 1251 (Fed. Cir. 2008). The issue therefore is whether a skilled artisan in 1997 would  
 7 have understood with reasonable certainty based on the specification and prosecution  
 8 history what the inventor meant by a “small” application program and therefore understood  
 9 what comes within the scope of the claims.

10 The ‘510 patent, incorporated into all the later patents, describes a Downloadable as  
 11 an “applet,” a small interpretable or executable application program, and provides that “a  
 12 Downloadable is used in a distributed environment such as the Java™ distributed  
 13 environment produced by Sun Microsystems or in the Active X™ distributed environment  
 14 produced by Microsoft Corporation.” See ‘520 Patent, at Col. 1:31-32, 34-38. Because  
 15 such examples existed in the 1990s, there should be an objective standard for the size of a  
 16 “small” program. While “absolute or mathematical precision” was not required, some  
 17 objective boundary should be identifiable from the disclosed embodiments. *See Biosig*  
 18 *Instruments*, 738 F.3d at 1381.

19 Finjan opposed ESET’s initial motion for summary judgment for indefiniteness as  
 20 to the scope of “small” on the grounds that a numerical limitation or cut-off is not necessary  
 21 because a skilled artisan could determine if an application is “small” from the examples in  
 22 the ‘962 patent and based on the context. Finjan, however, did not provide an explanation  
 23 as to how that skilled artisan would therefore interpret “small” or the context that would  
 24 apply. [Doc. No. 610, at 8 and 15.]<sup>2</sup>

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25  
 26  
 27 <sup>2</sup> Finjan has also argued that the Court should reconsider its incorporation of “small” into the construction  
 28 of Downloadable and disregard that modifier as other district courts have done to avoid this definiteness  
 issue. [Doc. No. 812, at 6.] This solution may resolve Finjan’s problem with defining “small,” but the fact  
 that the Court’s construction results in indefiniteness is not a basis for reconsideration.

1       ESET argued then, as it does now, that Finjan's experts did not provide any objective  
 2 boundaries for a "small" application program based on what a skilled artisan would have  
 3 understood was upper end of "small" in the context of application programs being  
 4 downloaded from a source computer to run on a destination computer at the time the  
 5 application was filed. [Doc. No. 816, at 5.] Finjan's contention that the understanding of  
 6 what is "small" depends on the context is not supported by the intrinsic evidence or even  
 7 extrinsic evidence of the state of the art at the relevant time. It amounted to "unpredictable  
 8 vagaries of any one person's opinion" and therefore failed to provide sufficient notice as  
 9 to the scope of the term. *Interval Licensing*, 766 F.3d at 1371 ("[A] term of degree fails to  
 10 provide sufficient notice of its scope if it depends on the unpredictable vagaries of any one  
 11 persons' opinion.")

12      ESET contends that the trial testimony of Finjan expert Dr. Eric Cole did not remedy  
 13 this defect.<sup>3</sup> Dr. Cole presented an explanation how a skilled artisan would interpret  
 14 "small" that was neither disclosed in his previous declaration to the Court (small meant "a  
 15 few megs ... something that is not multiple gigs or really large" [Doc. No. 806-1, at 17])  
 16 or anchored to the specification or prosecution history. Rather than providing a range of  
 17 application size that would have been construed as "small" by an artisan in 1997, Dr. Cole  
 18 testified on Finjan's behalf that an application would be understood to be small if it "did  
 19 not require installation" and opined that "small" depends not on size but on the function.  
 20 Dr. Cole testified that a small executable is an application that does not require installation  
 21 is "self-contained" and is "just running automatically" which is "typical if you go to any  
 22 website nowadays," whereas an executable that is not small "requires installation" and has  
 23 "a lot of shared libraries and dlls and other programs" in order to run. [Doc. No. 812, at  
 24 12.] Dr. Cole testified that regardless of time period, Internet speed and other factors related

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25  
 26      <sup>3</sup> Although the trial was terminated early due to the pandemic, Dr. Cole's testimony was completed. Finjan  
 27 suggests that Dr. Cole's testimony at a future trial will replace his completed testimony, but a subsequent  
 28 trial is not an opportunity for Dr. Cole to change his opinions or supplement them with support he did not  
 provide on the record at the first trial. [Doc. No. 816, at 11.]

1 to capacity, what fits the criteria of “small” may change but this distinction (installed or  
2 not installed) is constant. Dr. Cole did not however provide support from the specification,  
3 the prosecution history, or from any extrinsic sources in the relevant time period, for this  
4 new explanation that a skilled artisan in 1997 would understand “small” to be “uninstalled”  
5 or “not requiring installation.”

6 In sum, Finjan never offered evidence of a reasonable range for the size of a small  
7 executable or interpretable application program as understood by a skilled artisan in 1997  
8 based on examples provided in the patent specification. Instead, Finjan elected at trial to  
9 offer a new understanding without reference to the size of the application as the objective  
10 boundary of a “small” application. Finjan’s new definition is not supported by the  
11 specification or prosecution history. It may be convenient to support Finjan’s  
12 infringement contentions against ESET’s accused devices, but Finjan’s new explanation  
13 does provide clear notice of what constitutes a “small executable or interpretable  
14 application program.”

15 **IV. Conclusion**

16 For the foregoing reasons, the Court finds that the term “Downloadable” as used  
17 in the patents at-issue is indefinite. Accordingly, it is hereby **ORDERED** that ESET’s  
18 motion for summary judgment of invalidity of Finjan’s United States Patent Nos.  
19 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 for indefiniteness is  
20 **GRANTED.**

21 It is **SO ORDERED.**

22 Dated: March 23, 2021



23  
24 Hon. Cathy Ann Bencivengo  
25 United States District Judge  
26  
27  
28

# EXHIBIT B

1 Juanita R. Brooks (CA SBN 75934); brooks@fr.com  
2 Roger A. Denning (CA SBN 228998); denning@fr.com  
3 Frank J. Albert (CA SBN 247741); albert@fr.com  
4 Megan A. Chacon (CA SBN 304912); chacon@fr.com  
5 K. Nicole Williams (CA SBN 291900); nwilliams@fr.com  
6 Oliver J. Richards (CA SBN 310972); ojr@fr.com  
7 Jared A. Smith (CA SBN 306576); jasmith@fr.com  
8 Tucker N. Terhufen (CA SBN 311038); terhufen@fr.com  
FISH & RICHARDSON P.C.  
12860 El Camino Real, Suite 400  
San Diego, CA 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

9 Aamir Kazi (Admitted *Pro Hac Vice*); kazi@fr.com  
10 Alana C. Mannige (CA SBN 313341); mannige@fr.com  
FISH & RICHARDSON P.C.  
11 1180 Peachtree Street NE, 21st Floor  
Atlanta, GA 30309  
12 Telephone: (404) 892-5005  
Facsimile: (404) 892-5002

14 Attorneys for Plaintiff  
15 FINJAN LLC

16 UNITED STATES DISTRICT COURT  
17 NORTHERN DISTRICT OF CALIFORNIA  
18 (SAN JOSE DIVISION)

20 FINJAN LLC, a Delaware Limited Liability  
21 Company,

22 Plaintiff,

23 v.  
24 CISCO SYSTEMS, INC., a California  
25 Corporation,

26 Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**FINJAN LLC'S OPPOSITION TO CISCO  
SYSTEMS, INC.'S MOTION FOR  
JUDGMENT OF INVALIDITY OF THE  
'844, '780 AND '494 PATENTS BASED ON  
COLLATERAL ESTOPPEL**

1     **I. INTRODUCTION**

2                 Finjan’s Motion for Reconsideration of the ESET Court’s summary judgment order (the  
 3 “ESET Order”) is currently pending, having been filed on April 12, 2021. If granted, the decision  
 4 will undo the invalidity determination for the ’844 and ’780 Patents, and those patents could then  
 5 be included in the upcoming trial in this case. However, until that motion is ruled upon, the ESET  
 6 Order is not “sufficiently firm” to be accorded conclusive effect. And from a practical standpoint,  
 7 applying collateral estoppel now to find those patents invalid in this case runs the risk of having to  
 8 reverse course, should the Court in ESET grant the Motion for Reconsideration.

9                 The ’494 Patent was not asserted in ESET, so it is not addressed in the ESET Order.  
 10 Moreover, this Court has construed the term “downloadable” in the ’494 Patent in a manner that  
  11 does not include the term “small,” which was the basis for the ESET Court’s indefiniteness  
  12 determination as to the ’844 and ’780 Patents. And while Cisco argues collateral estoppel should  
  13 apply to the ’494 Patent, the decision to do so is completely within this Court’s discretion.

14     **II. BACKGROUND**

15                 Multiple courts—including in Finjan’s cases against McAfee, Blue Coat, Proofpoint,  
 16 Symantec, SonicWall, and Rapid7—have construed the term “downloadable” identical to the  
 17 Court’s construction in this case. Indeed, in this Court’s first *Blue Coat* trial, the jury found that  
 18 Blue Coat infringed claims of the ’844 and ’780 Patents by applying the Court’s construction of  
 19 “downloadable.” (*See* Exh.<sup>1</sup> A at 2-3.) The Federal Circuit affirmed those findings on appeal. *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1306-07 (Fed. Cir. 2018). With this track record of courts  
 20 consistently construing “downloadable” to have the same meaning, it is not surprising Cisco  
 21 stipulated to that same construction in this case (ECF 85 at 1), and that this Court adopted the  
 22 stipulated construction on July 23, 2018. (ECF 134 at 5.)

23                 In contrast, the construction of “downloadable” by the Court in ESET stands alone. It is the  
 24 only court that inserted the word “small” in the construction, as set out in the ESET Court’s claim  
 25

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26  
 27     <sup>1</sup> All exhibits cited herein are attached to the declaration of K. Nicole Williams ISO Finjan’s Opp’n  
 28 to Mot. For Judgment of Invalidity, filed contemporaneously herewith.

1 construction order on November 14, 2017. (See Exh. B at 3.) Yet even after the Court in ESET  
 2 entered its outlier construction, Cisco continued to urge this Court to adopt a construction that did  
 3 not include the word “small.” In the Joint Claim Construction and Pre-Hearing Statement, the  
 4 parties jointly requested that this Court construe “downloadable” without the word “small.” (ECF  
 5 85 at 1.) Cisco maintained that position in its claim construction briefing, in which, despite using  
 6 the term “downloadable” 285 times, Cisco never once used the word “small.” (ECF 112.) This  
 7 Court held a *Markman* hearing, and again Cisco did not withdraw its agreed-upon construction.  
 8 (ECF 132.) In July 2018, this Court construed the term “downloadable” as jointly requested by the  
 9 parties and in the same way the term had been construed in every case except ESET. (ECF 134 at  
 10 5.)

11       In Finjan’s action against ESET, a jury trial commenced on March 10, 2020, which was  
 12 halted shortly thereafter due to the COVID-19 pandemic. (See Exh. C.) On a renewed motion for  
 13 summary judgment following the mistrial, the ESET Court found that “Finjan never offered  
 14 evidence of a reasonable range for the size of a small executable” and held five Finjan patents invalid  
 15 as indefinite, including the ’780 and ’844 Patents asserted here. (See Exh. D at 8.) On April 12,  
 16 2021, Finjan moved for reconsideration of the ESET Order because there was clear error in shifting  
 17 the burden to Finjan to prove patent validity and the order was manifestly unjust since, at the time  
 18 of the mistrial, neither party had presented evidence on whether downloadable was indefinite. (See  
 19 generally Exh. E.)

### 20       **III.     LEGAL STANDARDS**

21       Collateral estoppel is considered under the law of the regional circuit. *RF Del., Inc. v. Pac.*  
 22 *Keystone Techs., Inc.*, 326 F.3d 1255, 1261 (Fed. Cir. 2003). In the Ninth Circuit, collateral estoppel  
 23 applies in a patent case if: “(1) the issue necessarily decided at the previous proceeding is identical  
 24 to the one which is sought to be re-litigated; (2) the first proceeding ended with a final judgment on  
 25 the merits; and (3) the party against whom collateral estoppel is asserted was a party or in privity  
 26 with a party at the first proceeding.” *Droplets, Inc. v. Yahoo! Inc.*, 2019 WL 5781915, at \*2 (N.D.  
 27 Cal. Oct. 15, 2019) (citing *Hydranautics v. FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000)). The  
 28 party asserting issue preclusion bears the burden of showing these elements are met. *Hydranautics*,

1 204 F.3d at 885. A “final judgment” for purposes of issue preclusion can be any prior adjudication  
 2 of an issue in another action that is determined to be “sufficiently firm” to be accorded conclusive  
 3 effect. *Elan Microelectronics Corp. v. Apple, Inc.*, 2010 WL 4510909, at \*3 n.3 (N.D. Cal. Nov. 1,  
 4 2010). The Ninth Circuit has set forth several factors that should be considered when determining  
 5 whether an order is “sufficiently firm” including “whether the parties were fully heard.” *See Abbott*  
 6 *Diabetes Care Inc. v. Roche Diagnostics Corp.*, 2007 WL 1239220, at \*12-\*13 (N.D. Cal. Apr. 27,  
 7 2007) (citing *Luben Indus., Inc. v. United States*, 707 F.2d 1037, 1040 (9th Cir. 1983)).

8 Even when all three elements are met, whether to apply the collateral estoppel bar is solely  
 9 within the court’s discretion. *United States v. Geophysical Corp. of Alaska*, 732 F.2d 693, 697 (9th  
 10 Cir. 1984). This broad discretion to trial courts allows them “to take potential shortcomings or  
 11 indices of unfairness into account when considering whether to apply . . . issue preclusion, even  
 12 where the above-listed standard prerequisites are met.” *Syverson v. Int’l Bus. Machines Corp.*, 472  
 13 F.3d 1072, 1078-79 (9th Cir. 2007); *see also Neev v. Alcon*, 2016 WL 9051170 at \*12-13 (C.D. Cal.  
 14 Dec. 22, 2016), *aff’d sub nom. Neev v. Alcon Lensx Inc.*, 774 F. App’x 680 (Fed. Cir. 2019)  
 15 (declining to apply collateral estoppel to claim construction where it would neither promote  
 16 uniformity nor judicial efficiency).

#### 17 IV. ARGUMENT

##### 18 A. Collateral Estoppel Is Not Yet Applicable As To The ‘844 and ‘780 Patents

19 Cisco has failed to meet its burden to show that collateral estoppel applies because the ESET  
 20 Order as to the ’844 and ’780 is not “sufficiently firm,” under *Hydranautics*. A Motion for  
 21 Reconsideration is pending and the ESET Court has not ruled upon that motion nor entered final  
 22 judgment.

23 The ESET Court’s original finding of indefiniteness as to the ’844 and ’780 was based on  
 24 an incomplete presentation of the evidence—the testimony of **one expert** who addressed  
 25 **infringement** on only **one of the five** patents before a mistrial was declared. (*See* Exh. E at 5-12.)  
 26 ESET, the party with the burden of proof on invalidity, had not even begun its case. The judge and  
 27 jury had yet to hear that ESET’s expert on invalidity had **never** opined that, in his opinion, the term  
 28 “small” rendered the claims indefinite. Nor had they heard that ESET’s invalidity expert had no

1 problem understanding and applying the term when analyzing the prior art. (See Exh. E at 5-7; Exh.  
 2 F at 5-8.) The ESET Court also did not account for the testimony of Finjan's expert on validity,  
 3 who—but for the mistrial—would have explained in rebuttal how a person of ordinary skill in the  
 4 art would understand the objective bounds of the claim term “downloadable.” (See Exh. F at 1-5.)  
 5 Given that the original ESET Order was entered before the parties were “sufficiently heard” and  
 6 Finjan's Motion for Reconsideration is still pending, finding the '844 and '780 patents invalid in  
 7 this case now would be premature. The Finjan action against ESET has not ended with final  
 8 judgment on the merits, and is insufficiently firm to create a preclusive effect. *See, e.g., Rambus*  
 9 *Inc. v. Hynix Semiconductor Inc.*, 569 F. Supp. 2d 946, 968 (N.D. Cal. 2008) (finding issue  
 10 preclusion did not apply to prior claim constructions where judgment in prior case was not final).

#### 11           **B.       The Court Should Decline to Apply Collateral Estoppel To The '494 Patent**

12           The Court has discretion to decline to apply collateral estoppel, even if it finds the Ninth  
 13 Circuit factors are satisfied. Here, considerations of fairness and uniformity counsel against applying  
 14 the collateral estoppel bar to the '494 Patent. *See, e.g., Neev*, 2016 WL 9051170 at \*12-13; *see also*  
 15 *Syverson*, 472 F.3d at 1078-79.

16           First, the '494 Patent was not before the ESET Court; therefore there has been no finding of  
 17 invalidity as to that patent. Second, this Court has construed the term “downloadable” in the claims  
 18 of the '494 Patent the same way seven of the eight courts have construed that term, i.e., one that  
 19 does not include the term “small.” The construction of “downloadable” in the ESET case stands in  
 20 contrast to each of the other cases, and the ESET Court's indefiniteness finding is predicated on that  
 21 outlier construction. This Court is not bound by the ESET Court's construction and, in fact, has said  
 22 that it does not intend to change the construction which the parties agreed to and have been operating  
 23 under throughout this case.

24           In light of all of the above, applying collateral estoppel to the '494 Patent would be counter  
 25 to the very rationale for the doctrine itself. Collateral estoppel is meant to prevent inefficient re-  
 26 litigation of identical issues and promote uniformity in the treatment of a given patent and prior  
 27 decisions. *See Neev*, 2016 WL 9051170 at \*12-13. Applying estoppel here would treat the '494  
 28

1 Patent *inconsistently* with six other cases – in which the courts’ construction has not created any  
 2 problems for juries, judges, or the parties.

3 In addition, from a fairness perspective, Cisco has consistently advocated for the  
 4 construction of “downloadable” that this Court adopted, even after the ESET Court entered its  
 5 outlier construction. Cisco is now seizing on the ESET Order, which is contrary to Cisco’s own  
 6 proposed construction, to try to avoid trial on the ’494, which was not before the court in ESET and  
 7 therefore, not the subject of the ESET Order. Finjan submits the fair path is for this Court to exercise  
 8 its discretion and decline to apply the collateral estoppel bar to the ’494 Patent. *See Syverson*, 472  
 9 F.3d at 1079.

10 None of Cisco’s cited cases require a different result. For example, *Ohio Willow Wood*  
 11 does not support Cisco’s sweeping conclusion that a court *must* apply the collateral estoppel bar if  
 12 the collateral estoppel factors are met. In that case, the defendant timely moved for summary  
 13 judgment based on collateral estoppel, the district court *chose* to grant the motion, and the Federal  
 14 Circuit affirmed. *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1341-43 (Fed. Cir.  
 15 2013). Likewise, in the *Nestle USA* and *Papst Licensing* cases, the Federal Circuit affirmed PTAB  
 16 claim construction decisions where collateral estoppel was applied. *See Nestle USA, Inc. v.*  
 17 *Stueben Foods, Inc.*, 884 F.3d 1350, 1352 (Fed. Cir. 2018); *Papst Licensing GMBH & Co. v.*  
 18 *Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019). Finally, in *Arunachalam v.*  
 19 *Presidio Bank*, 801 F. App’x 750 (Fed. Cir. 2020), the Federal Circuit merely affirmed the lower  
 20 court’s exercise of its discretion in *choosing* to apply the collateral estoppel bar. *Id.* at 753-54.  
 21 None of these cases suggest that this Court *must* apply collateral estoppel, or that the Federal  
 22 Circuit would fault this Court if, in considering fairness and uniformity, this Court *chooses* to  
 23 exercise its discretion and decline to apply the collateral estoppel bar to the ’494 Patent.

## 24 V. CONCLUSION

25 For the foregoing reasons Finjan respectfully requests the Court deny Cisco’s Motion as to  
 26 the ’844 and ’780 Patents unless and until final judgment is entered by the ESET Court and deny  
 27 Cisco’s motion as to the ’494 Patent and allow that patent to proceed to trial.

1 Dated: April 26, 2021

FISH & RICHARDSON P.C.

2

3

By: /s/ Juanita R. Brooks

4 Juanita R. Brooks

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6 Attorneys for Plaintiff  
7 FINJAN LLC

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25

26

27

28

1 Juanita R. Brooks (CA SBN 75934); brooks@fr.com  
2 Roger A. Denning (CA SBN 228998); denning@fr.com  
3 Frank J. Albert (CA SBN 247741); albert@fr.com  
4 Megan A. Chacon (CA SBN 304912); chacon@fr.com  
5 K. Nicole Williams (CA SBN 291900); nwilliams@fr.com  
6 Oliver J. Richards (CA SBN 310972); ojr@fr.com  
7 Jared A. Smith (CA SBN 306576); jasmith@fr.com  
8 Tucker N. Terhufen (CA SBN 311038); terhufen@fr.com  
FISH & RICHARDSON P.C.  
12860 El Camino Real, Suite 400  
San Diego, CA 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

9 Aamir Kazi (Admitted *Pro Hac Vice*); kazi@fr.com  
10 Alana C. Mannige (CA SBN 313341); mannige@fr.com  
FISH & RICHARDSON P.C.  
11 1180 Peachtree Street NE, 21st Floor  
Atlanta, GA 30309  
12 Telephone: (404) 892-5005  
Facsimile: (404) 892-5002

14 Attorneys for Plaintiff  
15 FINJAN LLC

16 UNITED STATES DISTRICT COURT  
17 NORTHERN DISTRICT OF CALIFORNIA  
18 (SAN JOSE DIVISION)

19 FINJAN LLC, a Delaware Limited Liability  
20 Company,

Case No. 5:17-cv-00072-BLF-SVK

21 Plaintiff,

**DECLARATION OF K. NICOLE  
WILLIAMS IN SUPPORT OF FINJAN  
LLC'S OPPOSITION TO CISCO  
SYSTEMS, INC.'S MOTION FOR  
JUDGMENT OF INVALIDITY OF THE  
'844, '780 AND '494 PATENTS BASED ON  
COLLATERAL ESTOPPEL**

22 v.  
23 CISCO SYSTEMS, INC., a California  
24 Corporation,

25 Defendant.

26  
27 DECLARATION OF K. NICOLE WILLIAMS IN  
28 SUPPORT OF FINJAN'S OPPOSITION TO  
CISCO'S MOTION FOR JUDGMENT OF  
INVALIDITY  
Case No. 5:17-cv-00072-BLF-SVK

1 I, K. Nicole Williams, hereby declare and state as follows:

2 1. I am a principal in the law firm of Fish & Richardson P.C., counsel of record for  
3 Plaintiff Finjan LLC in the above-captioned matter. I have personal knowledge of all the facts  
4 contained herein and, if called as a witness, I could and would testify competently thereto.

5 2. Attached as Exhibit A is a true and correct copy of *Finjan Inc. v. Blue Coat Sys., Inc.*, No. 5-13-cv-03999, ECF 438 (N.D. Cal. Aug. 4, 2015).

6 3. Attached as Exhibit B is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 195 (S.D. Cal. Nov. 14, 2017).

7 4. Attached as Exhibit C is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 783 (S.D. Cal. Mar. 16, 2020).

8 5. Attached as exhibit D is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 869 (S.D. Cal. Mar. 29, 2021).

9 6. Attached as Exhibit E is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 872-1 (S.D. Cal. April 12, 2021).

10 7. Attached as Exhibit F is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 872-2 (S.D. Cal. April 12, 2021).

11 I declare under the penalty of perjury of the laws of the United States of America that the  
12 foregoing is true and correct. Executed on April 26, 2021, in Cardiff, California.

13 By: /s/ K. Nicole Williams  
14 K. Nicole Williams

# EXHIBIT A

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

**FINJAN, INC., a Delaware Corporation,**

Plaintiff,

BLUE COAT SYSTEMS, INC., a Delaware  
Corporation,

**Defendant.**

Case No.: 13-CV-03999-BLF

## VERDICT FORM

## **VERDICT FORM**

When answering the following questions and filling out this Verdict Form, please follow the directions provided throughout this Verdict Form. Your answer to each question must be unanimous. Some of the questions contain legal terms that are defined and explained in detail in the Jury Instructions. Please refer to the Jury Instructions if you are unsure about the meaning or usage of any legal term that appears in the questions below.

We, the jury, unanimously agree to the answers to the following questions and return them under the instructions of this court as our verdict in this case.

1      **QUESTION 1:** Did Finjan prove by a preponderance of the evidence that Blue Coat's product or  
 2 combination of products as identified below literally infringes any of the following claims of the  
 3 Asserted Patents? Answer "Yes" or "No" for each claim.

<b>'844 Patent</b> <b>WebPulse</b>	Claim 1 <u>Yes</u> Claim 15 <u>Yes</u>
	Claim 7 <u>Yes</u> Claim 41 <u>Yes</u>
	Claim 11 <u>Yes</u>
<b>'822 Patent</b> <b>ProxySG</b>	Claim 9 <u>No</u> Claim 10 <u>No</u>
<b>'633 Patent</b> <b>ProxySG + CAS +</b> <b>MAA</b>	Claim 14 <u>No</u>
<b>'731 Patent</b> <b>ProxySG + WebPulse</b>	Claim 1 <u>Yes</u> Claim 17 <u>Yes</u>
<b>'968 Patent</b> <b>ProxySG + WebPulse</b>	Claim 1 <u>Yes</u>
<b>'780 Patent</b> <b>ProxySG + ProxyAV</b>	Claim 9 <u>Yes</u> Claim 13 <u>Yes</u>

26      For each claim you did not find to be literally infringed, answer Question 2.  
 27  
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1      **QUESTION 2:** Did Finjan prove by a preponderance of the evidence that Blue Coat's product or  
 2 combination of products as identified below infringe under the doctrine of equivalents? **Answer**  
 3 "Yes" or "No" for each claim.

<b>'844 Patent</b> <b>WebPulse</b>	Claim 1 <u>Yes</u>	Claim 7 <u>Yes</u>
	Claim 11 <u>Yes</u>	
<b>'822 Patent</b> <b>ProxySG</b>	Claim 9 <u>No</u>	Claim 10 <u>No</u>
<b>'633 Patent</b> <b>ProxySG + CAS +</b> <b>MAA</b>	Claim 14 <u>Yes</u>	
<b>'968 Patent</b> <b>ProxySG + WebPulse</b>	Claim 1 <u>Yes</u>	
<b>'780 Patent</b> <b>ProxySG + ProxyAV</b>	Claim 9 <u>Yes</u>	Claim 13 <u>Yes</u>

1           **QUESTION 3:** What are the dates of invention for the '844 Patent and the '731 Patent?

2           '844 Patent: November 8, 1996

3

4           '731 Patent November 6, 1997

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7           Regardless of the dates you find, please answer Question 4 with respect to each patent.

1      **QUESTION 4:** Did Blue Coat prove by clear and convincing evidence that any of the following  
 2      claims of the Asserted Patents are invalid because they are anticipated? Answer "Yes" or "No" for  
 3      each claim.

<b><u>'844 Patent</u></b> <b>U.S. Patent No.</b> <b>6,253,370 ("Abadi")</b>	Claim 1 <u>No</u> Claim 15 <u>No</u>  Claim 7 <u>No</u> Claim 41 <u>No</u>  Claim 11 <u>No</u>
<b><u>'822 Patent</u></b> <b>U.S. Patent No.</b> <b>5,983,348 ("Ji")</b>	Claim 9 <u>No</u> Claim 10 <u>No</u>
<b><u>'633 Patent</u></b> <b>U.S. Patent No.</b> <b>5,983,348 ("Ji")</b>	Claim 14 <u>No</u>
<b><u>'731 Patent</u></b> <b>IBM WebSphere Edge Server: New Features and Function in Version 2, IBM Redbooks ("Braswell")</b>	Claim 1 <u>No</u> Claim 17 <u>No</u>
<b><u>'968 Patent</u></b> <b>U.S. Patent No.</b> <b>6,722,214 ("McClain")</b>	Claim 1 <u>No</u>
<b><u>'780 Patent</u></b> <b>U.S. Patent No.</b> <b>5,815,709 ("Waldo")</b>	Claim 9 <u>No</u> Claim 13 <u>No</u>

1 Answer Question 5(a)-(f) only if you have found one or more claims of the Asserted Patents to be  
2 infringed and not invalid from Questions 1, 2 and 4.

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4 **QUESTION 5(a):** If you found any of the asserted claims of the '844 Patent to be infringed and not  
5 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably  
6 compensate it for Blue Coat's infringement for the life of the patent?

7 \$ 24,000,000  
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10 **QUESTION 5(b):** If you found any of the asserted claims of the '822 Patent to be infringed and not  
11 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably  
12 compensate it for Blue Coat's infringement for the life of the patent?

13 \$ 0  
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15 **QUESTION 5(c):** If you found the asserted claim of the '633 Patent to be infringed and not invalid,  
16 what amount of damages has Finjan proven it is entitled to that would fairly and reasonably  
17 compensate it for Blue Coat's infringement for the life of the patent?

18 \$ 1,666,700  
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20 **QUESTION 5(d):** If you found any of the asserted claims of the '731 Patent to be infringed and not  
21 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably  
22 compensate it for Blue Coat's infringement for the life of the patent?

23 \$ 6,000,000  
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25 [continued to the next page]  
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**QUESTION 5(e):** If you found the asserted claim of the ‘968 Patent to be infringed and not invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably compensate it for Blue Coat’s infringement for the life of the patent?

\$ 7,750,000

**QUESTION 5(f):** If you found any of the asserted claims of the ‘780 Patent to be infringed and not invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably compensate it for Blue Coat’s infringement for the life of the patent?

\$ 111,787

1 You have now reached the end of the verdict form and should review it to ensure it accurately  
2 reflects your unanimous determinations. The Presiding Juror should then sign and date the verdict  
3 form in the spaces below and notify the Security Guard that you have reached a verdict. The Presiding  
4 Juror should retain possession of the verdict form and bring it when the jury is brought back into the  
5 courtroom.

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7 DATED: August 4th, 2015  
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10 By:   
11 Presiding Juror  
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## EXHIBIT B

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability  
and ESET SPOL. S.R.O., a Slovak  
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-(BGS)

**CLAIM CONSTRUCTION ORDER**

On September 25 and 26, 2017, the Court held a hearing to construe certain terms and phrases of the following patents: U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; 9,219,755; and 7,975,305. The parties submitted briefing in accordance with this District's local patent rules and the case management order. A tutorial was presented by both sides to assist the Court with the history and background of the patents.

The Court requested further briefing regarding certain terms. Having now considered all the submissions of the parties, the arguments of counsel and for the reasons set forth at the hearing and herein, the Court hereby enters the claim constructions set forth below.

1           **A. “Downloadable” in U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086;**  
 2           **9,189,621 and 9,219,755**

3           The parties seek construction of the term **Downloadable** as it is used in five of the  
 4           patents at issue. This claim term can be traced through two branches of the family tree of  
 5           this patent (*see* Attachment A) with somewhat differing definitions. The Court however  
 6           concludes that the variations between the definitions can be reconciled and the  
 7           specifications in their entirety give notice of what is encompassed by the claim term  
 8           **Downloadable** to one of skill in the art.

9           **Downloadable** initially appears as a defined term in the specification of the  
 10          6,167,520 patent, and its continuation the 6,480,962 patent, as *a small executable or*  
          *interpretable application program which is downloaded from a source computer and run*  
 12          *on a destination computer.*

13          The specification of the 6,092,194 patent, and its continuation the ‘780 patent (which  
 14          is at issue in this litigation), define **Downloadable** as *an executable application program*  
          *which is downloadable from a source computer and run on the destination computer.* The  
 16          specification however provides as examples of a **Downloadable**, application programs  
 17          such as Java™ applets, known as little application programs in machine language, and  
 18          JavaScripts™ scripts, an interpretable application program. These examples are in accord  
 19          with the definition, incorporated by reference, set forth in the ‘520 patent. The ‘194 patent  
 20          and its progeny therefore conform to the ‘520 patent’s definition of **Downloadable** as *small*  
          *executable or interpretable application programs* through the use of the examples in the  
 22          specifications. The Court finds that one of skill in the art would be able to ascertain what  
 23          is claimed as a **Downloadable** in the context of these patents, and that in light of the  
 24          examples provided in the ‘194 patent specification, concludes that the meaning of  
 25          **Downloadable** is consistent with the definition provided in the ‘520 patent.

26          The ‘844 patent (which is at issue in this litigation) defines **Downloadable** as *an*  
          *executable application program which is downloadable from a source computer and run*  
 28          *on the destination computer* and also includes references to small executable and

1 interpretable application programs as examples of a **Downloadable**. The ‘844 patent  
 2 incorporates by reference the ‘520 patent and ‘194 patent. The Court finds that the  
 3 definition of **Downloadable** based on the ‘844 patent specification, the examples provided  
 4 therein and the incorporation of the ‘520 patent and the ‘194 patent, informs one of skill in  
 5 the art with reasonable certainty the scope of the invention. The entirety of the  
 6 specification’s description would inform that **Downloadable** includes executable and  
 7 interpretable application programs, in accordance with the examples and incorporated  
 8 references.

9       The ‘822 patent is a Continuation in Part of both the ‘962 patent and ‘780 patent and  
 10 incorporates those patents by reference. Its continuation patents, including the ‘086 patent,  
 11 ‘621 patent and ‘755 patent, which are at issue in this litigation, do not include a definition  
 12 of **Downloadable** in the specification but incorporate by reference the ’962 patent and the  
 13 ‘780 patent, and their definitions and examples of a **Downloadable**.

14      The Court finds that the two branches of the family tree of the patents at issue inform  
 15 that a **Downloadable** in the context of these patents means a *small executable or*  
*interpretable application program which is downloaded from a source computer and run*  
*on a destination computer*. This construction comports with the plain definition set forth  
 16 in the ‘520 patent and the ‘962 patent, and is supported by the written description including  
 17 the definition and the examples set forth in the ‘194 patent and its progeny, and in the  
 18 entirety of specification of the ‘844 patent.

19      The Court therefore construes the term **Downloadable** in all five patents as *a small*  
*executable or interpretable application program which is downloaded from a source*  
*computer and run on a destination computer*.

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1                   **B. U.S. Patent No. 6,154,844**

2                   The parties sought construction of the following phrase appearing in various claims of  
 3                   the ‘844 patent: **before the web server makes the Downloadable available to web**  
 4                   **clients.** The Court’s construction for this term is: *Before the Downloadable is available*  
 5                   *on a web server to be called up or forwarded to a web client.* (‘844 @ Col. 3:32-52; Col.  
 6                   4:65 - Col. 5:13; Figure 1.)

7                   **C. U.S. Patent No. 6,804,780**

8                   The parties sought construction of the following terms and phrases appearing in  
 9                   various claims of the ‘780 patent. The Court’s constructions for these terms are:

Claim Term	COURT’S CONSTRUCTION
<b>software components required to be executed by the Downloadable</b>	<i>components of code that the Downloadable is required to execute</i> (agreed construction)
<b>ID generator</b>	Defendant’s request for application of 112 ¶6 denied. “ID generator” is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
<b>performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID</b>	<i>performing a hashing function on the Downloadable together with its fetched software components</i> (Adopting PTO Construction from the IPR of the ‘780 patent April, 2016.)

1           **D. U.S. Patent No. 7,975,305**

2           The parties sought construction of the following phrase appearing in various claims  
 3 of the ‘305 patent, **network interface, housed within a computer**. Defendant’s proposed  
 4 construction that “housed within a computer” necessarily limits the structure of the network  
 5 interface to a hardware component is declined. The specification includes software  
 6 interface examples. The Court therefore finds in the context of the patent, the use of  
 7 “housed” in contrast to “stored” does not dictate that the claim be limited to hardware  
 8 components. To the extent clarification is required the Court construes this phrase as  
 9 ***network interface, contained within the computer.***

10          The parties agreed construction for **database, a collection of interrelated data  
 11 organized according to a database schema to serve one or more applications**, is adopted.

12           **E. U.S. Patent No. 8,079,086**

13          The parties sought construction of the following terms appearing in various claims  
 14 of the ‘086 patent. The Court’s constructions for these terms are:

15 <b>Claim Term</b>	16 <b>COURT’S CONSTRUCTION</b>
16 <b>appended Downloadable</b>	<p>17           <i>a Downloadable with a representation of the    18           DSP data attached to the end of the    19           Downloadable</i></p> <p>20           Declaration of Dr. Spafford, ¶¶36-39, and    21           references cited therein, that one skilled in the    22           art at the time would understand “append” to    23           mean attach or add to the end of the existing file.    24           The claim recites appending a representations of    25           the DSP data to the Downloadable indicating an    26           order.</p>
26 <b>destination computer</b>	<p>27           <i>Separate computer receiving the appended    28           Downloadable</i></p>

1 2 3 4 5 6	<b>file appender</b>  Defendant's request for application of 112 ¶ 6 is denied. "File appender" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
7 8 9 10 11	<b>Transmitter</b>  Defendant's request for application of 112 ¶ 6 is denied. "Transmitter" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art.

## 12 F. U.S. Patent No. 9,189,621

13 The parties sought construction of the following terms appearing in various claims  
 14 of the '621 patent. The Court's constructions for these terms are:

16 <b>Claim Term</b>	<b>COURT'S CONSTRUCTION</b>
17 18 19 20 21 22 23 24 25 26 27 28 <b>wherein the information pertaining to the downloadable includes information pertaining to operation of the downloadable and distinct from information pertaining to the request</b>	Defendant asserts that this phrase is indefinite as it is not possible to ascertain the meaning of "information pertaining to the operation of the downloadable that is distinct from information pertaining to the request." The Court finds that in the context of the claim in its entirety and for the reasons set forth on the record, one of skill in the art would understand the meaning and scope of this claim language, and no further construction is needed.
<b>a response engine for performing a predetermined</b>	Defendant asserts that use of "response engine" is the equivalent of "means for" claiming and is

1 2 3 4 5 6 7 8 9 10 11 12 13	<p><b>responsive action based on the comparison</b></p> <p>limited to the structures disclosed in the ‘520 Patent at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art.</p> <p>Defendant’s request for application of 112 ¶ 6 is denied.</p>
14 15 16 17 18 19 20 21 22 23	<p><b>a response engine for performing a predetermined responsive action based on the comparison with the information pertaining to the predetermined suspicious downloadable</b></p> <p>Defendant asserts that “response engine” is the equivalent of “means for” claiming and no structure to perform this function is disclosed. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” “Engine” is not a nonce term.</p> <p>Defendant’s request for application of 112 ¶ 6 is denied.</p>
24 25 26 27 28	<p><b>Database</b></p> <p><i>a collection of interrelated data organized according to a database schema to serve one or more applications</i></p> <p>(joint construction)</p>

1       The final construction at issue with regard to the ‘621 patent is a “means for”  
 2 limitation. An element of a claim may be expressed as a means for performing a specified  
 3 function without the recital of the structure and is construed to cover the corresponding  
 4 structure described in the specification or equivalents thereof. 35 U.S.C. § 112, ¶ 6. The  
 5 limitation at issue appears in claim 15, which is dependent on claim 10.

6       Claim 10. A system for reviewing an operating system call issued by a  
 7 downloadable, comprising:

8       ...

9       a plurality of operating system probes for monitoring substantially in parallel  
 10 a plurality of subsystems of an operating system during runtime for an event  
 caused from a request made by a Downloadable, wherein the plurality of  
 subsystems includes a network system;

11       ....

12       Claim 15. The system of claim 10, wherein the plurality of operating system  
 13 probes operating substantially in parallel for monitoring the operating system  
 includes **means for monitoring a request sent to a downloadable engine.**

14       The parties agree that the “means for” element of claim 15 is governed by 35 U.S.C.  
 15 § 112, ¶ 6. The patent specification must disclose with sufficient particularity the  
 16 corresponding structure for performing the claimed function and clearly link that structure  
 17 to the function. *Triton Tech of Tx., LLC. V. Nintendo of Am., Inc.*, 753 F.3d 1375, 1378  
 18 (Fed. Cir. 2014). The claimed function is “monitoring a request sent to a downloadable  
 19 engine.” After the claim construction hearing, the Court requested supplemental briefing  
 20 from the parties identifying with sufficient particularity the corresponding structure in the  
 21 specification for performing the claimed function. [Doc. 178-1.]

22       The plaintiff refers to the specification of the ‘962 patent [Doc. No. 138-9],  
 23 incorporated by reference in the ‘621 patent, for the corresponding structure that supports  
 24 this “means for” claim. Plaintiff directs the Court to the component identified in the  
 25 specification as the request broker 306 described at Col. 4:12-18, Figs. 3 and 4 [*id.* at 6-7,  
 26 12] as the corresponding structure providing the function in the system of monitoring a  
 27 request sent to a downloadable engine. [See Doc. No. 183 at 3.]

1       The specification describes the system for monitoring requests made by a  
 2 Downloadable 140 to a downloadable engine 250 at Col. 3:51 – Col. 5:48. [Doc. No. 138-  
 3 9, at 6-7, 12-13.] In the examples provided (*see* Figs. 3 and 4), extensions 304, 404, 405,  
 4 406 examine a Downloadable's request for access to classes 302 of a Java™ Virtual  
 5 Machine (the downloadable engine 250) or to message calls 401, DDE calls 402 and DLL  
 6 calls 403 of a ActiveX™ platform (the downloadable engine 250). The Downloadable's  
 7 request to the downloadable engine may be interrupted by the extension which then notifies  
 8 the request broker 306 of the Downloadable's request. The request broker 306 in turn  
 9 forwards the request to the event router 308. [*Id.*]

10      The extensions 304, 404, 405, 406 monitor requests made to the downloadable engine  
 11 250. Col. 5:40-49 (the extensions recognize a request made by a Downloadable to the  
 12 downloadable engine, interrupt the processing of the request and generate and forward a  
 13 message identifying the incoming Downloadable to request broker which forwards the  
 14 message to the event router.); Col. 4:10-15 (each extension 304 manages a respective one  
 15 of the Java™ classes, interrupts the request and generates a message to the request broker  
 16 306); Col. 5:23-38 (each extension 404, 405, 406 recognizes a call to an ActiveX™  
 17 platform 401, 402, 403, and generates a message to the request broker 306). The request  
 18 broker 306 forwards the request on for further analysis and response. The structures  
 19 identified in the specification corresponding to a **means for monitoring a request sent to**  
 20 **a downloadable engine**, are the Java Class extensions 304, the Message Extension 404,  
 21 the Dynamic-Data-Exchange Extension 405 and Dynamically-Linked-Library Extension  
 22 406, and their equivalents.

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1           **F. U.S. Patent No. 9,219,755**

2           The parties sought construction of the following terms appearing in various claims  
 3 of the ‘755 patent. The Court’s constructions for these terms are:

Claim Term	COURT’S CONSTRUCTION
<b>a downloadable engine for intercepting a request message being issued by a downloadable to an operating system</b>	<p>Defendant asserts that “downloadable engine” is the equivalent of “means for” claiming and the disclosed structures disclosed to perform this function are a Java Virtual Machine 250 or Active X Platform 250 (‘960 patent, Col. 3:54-56; Fig. 3; Col. 5:25-27; Fig. 4). Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art.</p> <p>Defendant’s request for application of 112 ¶ 6 is denied.</p>
<b>intercepting an operating system call being issued by the downloadable to an operating system</b>	<i>stopping a request message before the request message is received by the operating system</i>
<b>a response engine for receiving a violation message from the runtime</b>	<p>Defendant asserts that use of “response engine” is the equivalent of “means for” claiming and is limited to the structures disclosed in the ‘520</p>

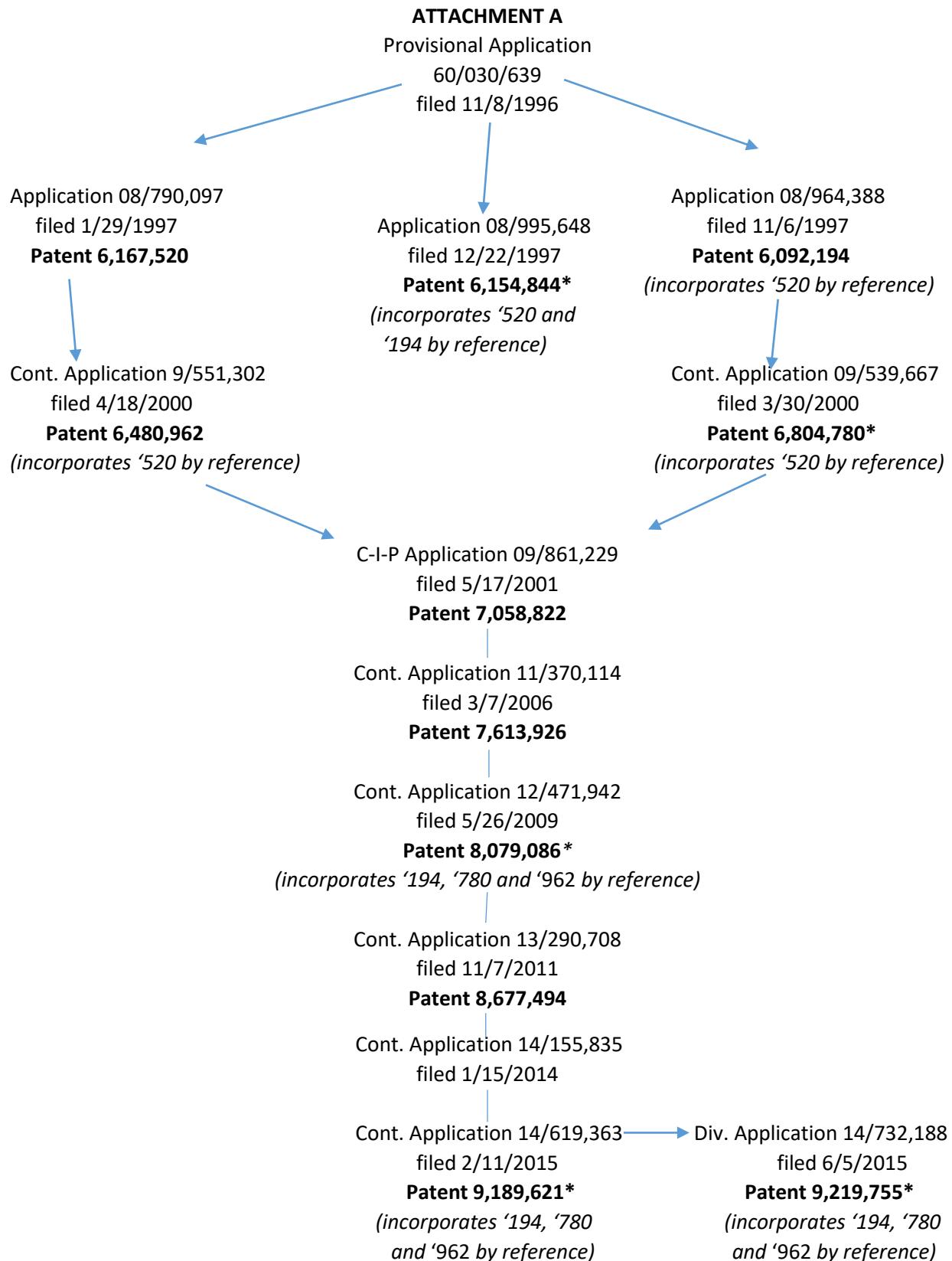
<b>environment ... and blocking ... and allowing ....</b>	Patent, at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant’s request for application of 112 ¶6 is denied.
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**It is SO ORDERED.**

Dated: November 14, 2017

  
Hon. Cathy Ann Bencivengo  
United States District Judge

# Attachment A



\*Patents at issue in the litigation.

# EXHIBIT C

This is an automatic e-mail message generated by the CM/ECF system. Please DO NOT RESPOND to this e-mail because the mail box is unattended.

\*\*\*NOTE TO PUBLIC ACCESS USERS\*\*\* Judicial Conference of the United States policy permits attorneys of record and parties in a case (including pro se litigants) to receive one free electronic copy of all documents filed electronically, if receipt is required by law or directed by the filer. PACER access fees apply to all other users. To avoid later charges, download a copy of each document during this first viewing. However, if the referenced document is a transcript, the free copy and 30 page limit do not apply.

U.S. District Court

Southern District of California

**Notice of Electronic Filing**

The following transaction was entered on 3/16/2020 at 10:35 AM PDT and filed on 3/16/2020

**Case Name:** Finjan, Inc. v. ESET, LLC et al

**Case Number:** [3:17-cv-00183-CAB-BGS](#)

**Filer:**

**Document Number:** 783 (No document attached)

**Docket Text:**

**Minute Entry for proceedings held before Judge Cathy Ann Bencivengo: Status reJury Trial completed on 3/16/2020. 0 Trial Jurors Present. The Court suspended jury trial proceedings and excused the jury for the day. With the agreement of counsel, the Court deems a Mistrial based upon the current state of extraordinary circumstances due to the Coronavirus/COVID-19 Pandemic. The Court will contact counsel upon the conclusion of the national state of emergency for further scheduling of court proceedings. All previously pending dates of trial are hereby vacated. (Court Reporter/ECR Mauralee Ramirez). (Plaintiff Attorney Paul Andre, James Hannah, Kristopher Kastens). (Defendant Attorney Nicola Pisano, Scott Penner, Regis Worley, Jr., Justin Gray). (no document attached) (lmh)**

**3:17-cv-00183-CAB-BGS Notice has been electronically mailed to:**

Jose L. Patino JosePatino@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us, MarilynBynum@eversheds-sutherland.com, NancyJohnson@eversheds-sutherland.com

Paul Joseph Andre pandre@kramerlevin.com, docketing-8870@ecf.pacerpro.com, litigation-5766@ecf.pacerpro.com, paul-andre-3422@ecf.pacerpro.com, svdocketing@kramerlevin.com

Lisa Kobialka lkobialka@kramerlevin.com, CTamondong@kramerlevin.com, docketing-8870@ecf.pacerpro.com, lisa-kobialka-3741@ecf.pacerpro.com, svdocketing@kramerlevin.com

Nicola Anthony Pisano NicolaPisano@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us, NancyJohnson@eversheds-sutherland.com

Regis C. Worley, Jr RegisWorley@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us

Kristopher B. Kastens kkastens@kramerlevin.com, docketing-8870@ecf.pacerpro.com, kristopher-kastens-7292@ecf.pacerpro.com, svdocketing@kramerlevin.com

Hannah Y. Lee hlee@kramerlevin.com, docketing-8870@ecf.pacerpro.com, hannah-lee-6671@ecf.pacerpro.com, svdocketing@kramerlevin.com

James R. Hannah jhannah@kramerlevin.com, docketing-8870@ecf.pacerpro.com, james-hannah-0441@ecf.pacerpro.com, svdocketing@kramerlevin.com

Justin Edwin Gray JustinGray@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us, NancyJohnson@eversheds-sutherland.com

Yuridia Caire ycaire@kramerlevin.com, docketing-8870@ecf.pacerpro.com, svdocketing@kramerlevin.com, yurida-caire-8080@ecf.pacerpro.com

Michael (Mike) H. Lee mhlee@kramerlevin.com

Scott A. Penner ScottPenner@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us, nancyjohnson@eversheds-sutherland.com

Christopher C. Bolten ChrisBolten@eversheds-sutherland.com, IPDocketingMailbox@eversheds-sutherland.us, NancyJohnson@eversheds-sutherland.com, maryfleury@eversheds-sutherland.com

Phuong D Nguyen Snguyen@kramerlevin.com

Aaron M. Frankel AFrankel@KRAMERLEVIN.com

Cristina Lynn Martinez cmartinez@kramerlevin.com

Benu C. Wells bwells@kramerlevin.com

Hien Khanh Lien hlien@kramerlevin.com

Gregory Carl Proctor gproctor@kramerlevin.com

Linjun Xu lxu@kramerlevin.com

**3:17-cv-00183-CAB-BGS Notice has been delivered by other means to:**

## EXHIBIT D

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability  
and ESET SPOL. S.R.O., a Slovak  
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**AMENDED ORDER ON  
DEFENDANTS' RENEWED MOTION  
FOR SUMMARY JUDGMENT OF  
INDEFINITENESS  
[Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

**I. Background**

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a

1 “Downloadable” based on the Court’s construction of that term, the Court denied the  
 2 motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would  
 3 establish what was generally understood in the art in 1997 as a “Downloadable” and such  
 4 testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

5 A jury trial commenced in this case on March 10, 2020. After three trial days the  
 6 Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial  
 7 due to the COVID-19 pandemic and the issuance of the State of California’s stay-home  
 8 order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and  
 9 backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

10 Having heard testimony from Finjan’s expert during the vacated trial on this issue,  
 11 however, the Court permitted ESET to renew this motion in consideration of the testimony  
 12 that was taken. Although Finjan’s patents have been the subject of much litigation, and  
 13 the term “Downloadable” has been construed by other courts, the issue raised in ESET’s  
 14 current motion does not appear to have been addressed by any prior constructions.

15 Finjan is the owner of a large family tree of patents for security systems and methods  
 16 of detecting malware in computer programs. Finjan has litigated many of their patents,  
 17 including some of the patents at-issue in this motion, in other district courts. Many have  
 18 also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The  
 19 Federal Circuit has issued at least nine opinions, precedential and non-precedential, on  
 20 appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders  
 21 or opinions discuss how earlier references incorporated into the patents at-issue inform the  
 22 construction of the term “Downloadable.”

## 23       **II.     The Construction of “Downloadable”**

24       In 2017, Finjan filed this litigation against defendants ESET asserting infringement  
 25 of the patents at-issue, and United States Patent No. 7,975,305.<sup>1</sup> Finjan claims priority for  
 26  
 27

---

28       <sup>1</sup> The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

1 the patents at-issue back to an application filed on November 8, 1996, Provisional  
2 Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and  
3 method for protecting computers from hostile Downloadables,” described as executable  
4 application programs automatically downloaded from a source computer and run on the  
5 destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term  
6 “Downloadable” is presented as a capitalized term in the provisional application and all the  
7 patents at-issue, signaling it is a specifically defined term. The definition of  
8 “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued  
9 patents. The explicit definitions include:

- 10 • “applets” (little applications) described in the 1990s as small interpreted or  
11 executable programs. *See* Provisional Application 60/030639 (filed  
12 November 8, 1996) [*Id.* at 5-6.]
- 13 • “Downloadables (i.e., applets)” as “a small executable or interpretable  
14 application program which is downloaded from a source computer and run  
15 on a destination computer,” in conformity with the original provisional  
16 application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed  
17 January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18,  
18 2000).
- 19 • “an executable application program which is downloaded from a source  
20 computer and run on a destination computer” (without “i.e., applet,” “small”  
21 or “interpretable” included in the definition but using applets and  
22 interpretable programs as examples of a “Downloadable” and incorporating  
23 the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col.  
24 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60  
25 (filed March 30, 2000).

26 Other district courts have determined that “Downloadable” lacked ordinary meaning  
27 when the patents were filed and construed it as “an executable application program which  
28 is downloaded from a source computer and run on a destination computer,” applying the

1 explicit definition from the ‘194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the  
2 term was not amenable to plain and ordinary meaning and the patent applicant intended to  
3 act as the lexicographer of this term, therefore the specification definition controls).] None  
4 of these orders, however, discussed the significance of the ‘520 patent’s definition  
5 incorporated into the ‘194 patent and its continuations. One district court, without  
6 explanation, applied the broader definition from the ‘194 patent specification to the  
7 construction of the term “Downloadable” in the ‘962 patent as “the same” definition [id.,  
8 at 3, fn. 4], disregarding the fact the ‘962 patent explicitly defines “Downloadable” as “a  
9 *small* executable or interpretable application program which is downloaded from a source  
10 computer and run on a destination computer.” *See U.S. Patent No. 6,480,962, at Col. 1:39-*  
11 *41 (emphasis added).*

12 Incorporation by reference provides a method for integrating material from various  
13 documents into a host document by citing such material in a manner that makes clear that  
14 the material is effectively part of the host document as if it were explicitly contained  
15 therein. *See Trustees of Columbia Univ. v. Symantec, 811 F.3d 1359, 1365-66 (Fed. Cir.*  
16 *2016) (citing Advanced Display Sys. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir.*  
17 *2000) (provisional applications incorporated by reference are effectively part of the*  
18 *specification as though it was explicitly contained therein.)). By incorporating the earlier*  
19 *definition of “Downloadable” from the ‘520 Patent into the ‘194 Patent and subsequent*  
20 *continuations (including the patents at-issue), the scope of the term is limited to “*small**  
21 *executable or interpretable application programs,” and not *all* executable application*  
22 *programs (emphasis added). See Symantec, 811 F.3d at 1365 (rejecting a broad*  
23 *interpretation of a claim term in part because a provisional application incorporated by*  
24 *reference the same term more narrowly defined.) Inconsistent language used later cannot*  
25 *support a broad claim construction when the explicit definition is incorporated from earlier*  
26 *patents in the family tree.*

27 In this case, the Court concluded that based on its incorporation by reference in all  
28 the patents at-issue, the explicit definition of “Downloadables” from the ‘520 patent and

1 the ‘962 patent, which is supported by the examples provided in the specification, is the  
 2 proper construction of “Downloadables” – “a small executable or interpretable application  
 3 program which is downloaded from a source computer and run on a destination computer.”  
 4 [Doc. No. 195.]

### 5       **III. The Indefiniteness Determination**

6       The Court’s claim construction, not unexpectedly, resulted in the present dispute as  
 7 to the scope of the modifier “small.” ESET argues that “small” is a term of degree with  
 8 no technical meaning or defined boundaries and there is insufficient information in the  
 9 intrinsic record for a skilled artisan to have clear notice of what constitutes a “small  
 10 executable or interpretable application program.” They further argue that this is  
 11 demonstrated by the inability of Finjan’s experts to come to a consistent opinion as to what  
 12 objective boundaries constitute a small application program. [806-1, at 5, 17.]

13      The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the  
 14 “specification shall conclude with one or more claims particularly pointing out and  
 15 distinctly claiming the subject matter which the applicant regards as his invention.” The  
 16 definiteness requirement focuses on whether “a patent’s claims, viewed in light of the  
 17 specification and prosecution history inform those skilled in the art about the scope of the  
 18 invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.  
 19 898, 910 (2014). The inquiry “trains on the understanding of a skilled artisan at the time  
 20 of the patent application.” *Id.* at 911.

21      Terms of degree must provide sufficient certainty to one of skill in the art to afford  
 22 clear notice of what is claimed and what is still open to the public. *See Biosig Instruments,*  
*Inc. v. Nautilus, Inc.*, 738 F.3d 1374, 1378 (Fed. Cir. 2015) (“When a ‘word of degree’ is  
 23 used, the court must determine whether the patent provides ‘some standard for measuring  
 24 that degree.’”); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)  
 25 (the definiteness standard must allow for a modicum of uncertainty but must also require  
 26 clear notice of what is claimed thereby apprising the public of what is still open to them).  
 27

1 Finjan's contention that the claim term "Downloadable" cannot be indefinite simply  
 2 because the Court was able to construe it by adopting the explicit definition provided by  
 3 the inventor in the '520 patent fails to address the issue raised by ESET. A defined term is  
 4 still indefinite if a person of ordinary skill in the art cannot translate the definition into  
 5 meaningfully precise claim scope. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d  
 6 1244, 1251 (Fed. Cir. 2008). The issue therefore is whether a skilled artisan in 1997 would  
 7 have understood with reasonable certainty based on the specification and prosecution  
 8 history what the inventor meant by a "small" application program and therefore understood  
 9 what comes within the scope of the claims.

10 The '510 patent, incorporated into all the later patents, describes a Downloadable as  
 11 an "applet," a small interpretable or executable application program, and provides that "a  
 12 Downloadable is used in a distributed environment such as the Java™ distributed  
 13 environment produced by Sun Microsystems or in the Active X™ distributed environment  
 14 produced by Microsoft Corporation." See '520 Patent, at Col. 1:31-32, 34-38. Because  
 15 such examples existed in the 1990s, there should be an objective standard for the size of a  
 16 "small" program. While "absolute or mathematical precision" was not required, some  
 17 objective boundary should be identifiable from the disclosed embodiments. *See Biosig*  
 18 *Instruments*, 738 F.3d at 1381.

19 Finjan opposed ESET's initial motion for summary judgment for indefiniteness as  
 20 to the scope of "small" on the grounds that a numerical limitation or cut-off is not necessary  
 21 because a skilled artisan could determine if an application is "small" from the examples in  
 22 the '962 patent and based on the context. Finjan, however, did not provide an explanation  
 23 as to how that skilled artisan would therefore interpret "small" or the context that would  
 24 apply. [Doc. No. 610, at 8 and 15.]<sup>2</sup>

---

25  
 26  
 27 <sup>2</sup> Finjan has also argued that the Court should reconsider its incorporation of "small" into the construction  
 28 of Downloadable and disregard that modifier as other district courts have done to avoid this definiteness  
 issue. [Doc. No. 812, at 6.] This solution may resolve Finjan's problem with defining "small," but the fact  
 that the Court's construction results in indefiniteness is not a basis for reconsideration.

1       ESET argued then, as it does now, that Finjan’s experts did not provide any objective  
 2 boundaries for a “small” application program based on what a skilled artisan would have  
 3 understood was upper end of “small” in the context of application programs being  
 4 downloaded from a source computer to run on a destination computer at the time the  
 5 application was filed. [Doc. No. 816, at 5.] Finjan’s contention that the understanding of  
 6 what is “small” depends on the context is not supported by the intrinsic evidence or even  
 7 extrinsic evidence of the state of the art at the relevant time. It amounted to “unpredictable  
 8 vagaries of any one person’s opinion” and therefore failed to provide sufficient notice as  
 9 to the scope of the term. *Interval Licensing*, 766 F.3d at 1371 (“[A] term of degree fails to  
 10 provide sufficient notice of its scope if it depends on the unpredictable vagaries of any one  
 11 persons’ opinion.”)

12       ESET contends that the trial testimony of Finjan expert Dr. Eric Cole did not remedy  
 13 this defect.<sup>3</sup> Dr. Cole presented an explanation how a skilled artisan would interpret  
 14 “small” that was neither disclosed in his previous declaration to the Court (small meant “a  
 15 few megs … something that is not multiple gigs or really large” [Doc. No. 806-1, at 17])  
 16 or anchored to the specification or prosecution history. Rather than providing a range of  
 17 application size that would have been construed as “small” by an artisan in 1997, Dr. Cole  
 18 testified on Finjan’s behalf that an application would be understood to be small if it “did  
 19 not require installation” and opined that “small” depends not on size but on the function.  
 20 Dr. Cole testified that a small executable is an application that does not require installation  
 21 is “self-contained” and is “just running automatically” which is “typical if you go to any  
 22 website nowadays,” whereas an executable that is not small “requires installation” and has  
 23 “a lot of shared libraries and dlls and other programs” in order to run. [Doc. No. 812, at  
 24 12.] Dr. Cole testified that regardless of time period, Internet speed and other factors related

---

25  
 26       <sup>3</sup> Although the trial was terminated early due to the pandemic, Dr. Cole’s testimony was completed. Finjan  
 27 suggests that Dr. Cole’s testimony at a future trial will replace his completed testimony, but a subsequent  
 28 trial is not an opportunity for Dr. Cole to change his opinions or supplement them with support he did not  
 provide on the record at the first trial. [Doc. No. 816, at 11.]

1 to capacity, what fits the criteria of “small” may change but this distinction (installed or  
2 not installed) is constant. Dr. Cole did not however provide support from the specification,  
3 the prosecution history, or from any extrinsic sources in the relevant time period, for this  
4 new explanation that a skilled artisan in 1997 would understand “small” to be “uninstalled”  
5 or “not requiring installation.”

6 In sum, Finjan never offered evidence of a reasonable range for the size of a small  
7 executable or interpretable application program as understood by a skilled artisan in 1997  
8 based on examples provided in the patent specification. Instead, Finjan elected at trial to  
9 offer a new understanding without reference to the size of the application as the objective  
10 boundary of a “small” application. Finjan’s new definition is not supported by the  
11 specification or prosecution history. It may be convenient to support Finjan’s  
12 infringement contentions against ESET’s accused devices, but Finjan’s new explanation  
13 does not provide clear notice of what constitutes a “small executable or interpretable  
14 application program.”

#### 15 IV. Conclusion

16 For the foregoing reasons, the Court finds that the term “Downloadable” as used  
17 in the patents at-issue is indefinite. Accordingly, it is hereby **ORDERED** that ESET’s  
18 motion for summary judgment of invalidity of Finjan’s United States Patent Nos.  
19 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 for indefiniteness is  
20 **GRANTED.**

21 It is **SO ORDERED.**

22 Dated: March 29, 2021



23  
24 Hon. Cathy Ann Bencivengo  
United States District Judge  
25  
26  
27  
28

## EXHIBIT E

1 Juanita R. Brooks (SBN 75934) brooks@fr.com  
2 Roger A. Denning (SBN 228998) denning@fr.com  
3 Jason W. Wolff (SBN 215819) wolff@fr.com  
4 Michael A. Amon (SBN 226221) amon@fr.com  
5 K. Nicole Williams (SBN 291900) nwilliams@fr.com  
6 FISH & RICHARDSON P.C.  
7 12860 El Camino Real, Suite 400  
8 San Diego, CA 92130  
9 Tel: (858) 678-5070 / Fax: (858) 678-5099

10 Lawrence Jarvis (*pro hac vice*)  
11 FISH & RICHARDSON P.C.  
12 1180 Peachtree St., NE  
13 21<sup>st</sup> Floor  
14 Atlanta, GA 30309  
15 Tel: (404) 891-5005 / Fax: (404) 892-5002

16 Attorneys for Plaintiff & Counter-Defendant FINJAN  
17 LLC

18 IN THE UNITED STATES DISTRICT COURT  
19 SOUTHERN DISTRICT OF CALIFORNIA

20 FINJAN LLC,

21 Plaintiffs,

22 v.

23 ESET, LLC and ESET SPOL. S.R.O.,

24 Defendants.

25 Case No. 17-cv-0183 CAB (BGS)

26 **PLAINTIFF FINJAN LLC'S  
27 MEMORANDUM OF POINTS AND  
28 AUTHORITIES IN SUPPORT OF ITS  
MOTION FOR RECONSIDERATION**

29 PER CHAMBERS RULES, NO ORAL  
30 ARGUMENT UNLESS SEPARATELY  
31 ORDERED BY THE COURT

32 Date: May 17, 2021

33 Courtroom: 15A

34 Judge: Hon. Cathy Ann Bencivengo

35  
36 AND RELATED COUNTERCLAIMS  
37  
38

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1     **I. INTRODUCTION**

2       In the context of a renewed motion for summary judgment following a mistral  
 3 due to the COVID-19 pandemic—in which neither party completed its presentation  
 4 of witnesses and evidence regarding patent infringement, and Defendants did not even  
 5 begin their case in chief on invalidity—the Court made critical rulings on  
 6 indefiniteness regarding U.S. Patents Nos. 6,154,844; 6,804,780; 8,079,086;  
 7 9,189,621; and 9,219,755 (“the Asserted Patents”).<sup>1</sup> (Doc. No. 869 (the “Order”)).

8       Finjan LLC (“Finjan”) respectfully requests the Court to reconsider the Order  
 9 because (1) there is clear error in requiring Finjan to produce evidence to establish the  
 10 Asserted Patents are valid—the burden falls squarely on Defendants to prove the  
 11 contrary; and (2) there is clear error in holding that Finjan did not offer evidence of a  
 12 range for the size of a “small” executable or interpretable application program, as  
 13 understood by one of skill in the art in 1997 and based on examples provided in the  
 14 patent specifications. (*See* Order at 8.)

15      First, respectfully, the Court’s holding is incorrect as a matter of law. Based  
 16 on a single word in the Court’s claim construction—namely the word “small”—  
 17 Defendants ESET, LLC and ESET SPOL. S.R.O. (together, “ESET”) have argued the  
 18 Asserted Patents are indefinite, thus rendering them invalid. Accordingly, ESET —  
 19 not Finjan—has the burden of proof to show by clear and convincing evidence that  
 20 the claims fail to satisfy the definiteness requirement under 35 U.S.C. § 112. *See*,  
 21 *e.g.*, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 912 (2014). ESET did  
 22 not meet this burden and indeed had not even begun its invalidity case when the trial  
 23 was halted due to the pandemic.

---

24  
 25  
 26      <sup>1</sup> The Court issued an original Order on March 23, 2021 on Defendants’ Renewed  
 27 Motion for Summary Judgment on Indefiniteness. (*See* Doc. No. 864.) The Court  
 28 issued an Amended Order on March 29, 2021. (Doc. No. 869.)

1       Second, the Court’s holding ignores critical issues of fact. The finding of  
 2 indefiniteness is based on an incomplete presentation of the evidence because the  
 3 Court evaluated only the testimony of Dr. Eric Cole, Finjan’s expert on infringement  
 4 on one of the five Asserted Patents (the ’844 Patent). The Court did not and could  
 5 not account for the testimony of Finjan’s expert on validity, Dr. Goodrich, who—but  
 6 for the mistrial—would have explained how a person of ordinary skill in the art  
 7 (“POSITA”) would understand the objective bounds of the claim term  
 8 “downloadable,” based on teachings from the patent specification. (*See generally*  
 9 Finjan’s Offer of Proof, filed concurrently herewith.) Moreover, ESET’s expert, Dr.  
 10 Eugene Spafford, who opined on the scope of the claims for purposes of both non-  
 11 infringement and invalidity—and critically offered no opinion on any alleged  
 12 indefiniteness of the term “downloadable”—also was not presented or cross-  
 13 examined at trial. Accordingly, the Court should reconsider its Order in light of the  
 14 incomplete factual record and expert testimony that precludes summary judgment.

## 15       II. PROCEDURAL BACKGROUND

16       On April 23, 2019, ESET filed a motion for summary judgment of invalidity  
 17 due to indefiniteness based on the Court’s construction of the term, “downloadable.”  
 18 (*See Doc. No. 478-1.*) The Court heard argument and denied the motion without  
 19 prejudice, finding that there were factual disputes regarding what a POSITA in 1997  
 20 would have understood constituted a “small” downloadable, based on the Court’s  
 21 construction.<sup>2</sup> (Doc. No. 699.)

22       A jury trial commenced on March 10, 2020, but was halted shortly thereafter  
 23 due to the COVID-19 pandemic. The Court excused the jury and declared a mistrial.  
 24 (*See Doc. No. 783.*) On August 21, ESET filed its renewed motion for summary

26       <sup>2</sup> Finjan understands that the Court’s construction of the term “downloadable,”  
 27 which includes the word “small,” is final. To be clear, Finjan maintains its  
 28 objection to the construction.

1 judgment on indefiniteness. (Doc. No. 806.) The Court allowed ESET to renew its  
 2 motion because it had heard testimony from one of Finjan's experts, Dr. Cole,  
 3 regarding what a "small" downloadable was at trial. The specific issue before the  
 4 Court on the renewed motion was whether a POSITA in 1997 would have understood  
 5 with reasonable certainty, based on the specification and prosecution history, what  
 6 was meant by the scope of not just any downloadable, but one that was "small." (Doc.  
 7 No. 869 at 6.) After reviewing the renewed motion and related briefing, the Court  
 8 issued its Order, holding that Finjan "never offered evidence of a reasonable range for  
 9 the size of a small executable or interpretable application program as understood by a  
 10 skilled artisan in 1997 based on examples provided in the patent specification." (Doc.  
 11 No. 869 at 8.) The Court did so without hearing all the evidence and testimony for  
 12 all Asserted Patents regarding what a POSITA would understand a "small"  
 13 downloadable to mean in the context of the various patents. Soon thereafter, the Court  
 14 entered an order to sever and stay the litigation of the '305 Patent (Doc. No. 871), and  
 15 granted Finjan the opportunity to file this motion for reconsideration (Doc. No. 870).

### 16 III. LEGAL STANDARDS

#### 17 A. Motions for Reconsideration

18 Reconsideration of a prior order "is appropriate if the district court (1) is  
 19 presented with newly discovered evidence, (2) committed clear error or the initial  
 20 decision was manifestly unjust, or (3) if there is an intervening change in controlling  
 21 law." *Sch. Dist. No. 1J, Multnomah Cty., Or. v. ACandS, Inc.*, 5 F.3d 1255, 1263 (9th  
 22 Cir. 1993). It is respectfully submitted that in shifting the burden of proof to Finjan  
 23 to prove the term "small" is not indefinite and in deciding the motion on an incomplete  
 24 record, the Court committed clear error and the Court's decision is manifestly unjust.

#### 25 B. Summary Judgment

26 "In the context of a motion for summary judgment, the Court must not weigh  
 27 the credibility of the evidence and determine the truth of the matter." *Finjan, Inc. v.*  
 28 *ESET, LLC*, 2019 WL 7290961, at \*1 (S.D. Cal. Dec. 30, 2019) (citing *Anderson v.*

1 *Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986)). Further, the non-movant’s evidence  
 2 is to be believed and all justifiable inferences are to be drawn in the non-movant’s  
 3 favor. *Id.* In its Order, the Court clearly weighed the credibility of Dr. Cole and did  
 4 not draw all reasonable inferences in favor of Finjan, the non-moving party. (Doc.  
 5 No. 869 at 7-8.)

### 6 C. Indefiniteness

7 Section 112 requires that a patent specification “conclude with one or more  
 8 claims particularly pointing out and distinctly claiming the subject matter which the  
 9 applicant regards as his invention.” *Sonix Tech. Co. v. Publications Int’l, Ltd.*, 844  
 10 F.3d 1370, 1377 (Fed. Cir. 2017). The Supreme Court has read this provision to  
 11 require that “a patent’s claims, viewed in light of the specification and prosecution  
 12 history, inform those skilled in the art about the scope of the invention with reasonable  
 13 certainty.” *Id.* (citing *Nautilus*, 572 U.S. at 910). Indefiniteness must be proven by  
 14 clear and convincing evidence. *Sonix Tech. Co.*, 844 F.3d at 1377. “The certainty  
 15 which the law requires in patents is not greater than is reasonable, having regard to  
 16 their subject-matter,” and the inquiry “trains on the understanding of a skilled artisan  
 17 at the time of the patent application.” *Nautilus*, 572 U.S. at 899, 910-11. “Because  
 18 language is limited,” the Federal Circuit has “rejected the proposition that claims  
 19 involving terms of degree are inherently indefinite.” *Sonix Tech. Co.*, 844 F.3d at  
 20 1377. Thus, “a patentee need not define his invention with mathematical precision in  
 21 order to comply with the definiteness requirement,” so long as it provides “enough  
 22 certainty to one of skill in the art when read in the context of the invention.” *Id.*  
 23 (internal citation omitted).

24 Following Supreme Court and Federal Circuit precedent, this Court has held  
 25 that terms of degree are not indefinite. For example, “words of degree — such as  
 26 ‘substantially’— are not considered indefinite so long as intrinsic evidence ‘provides  
 27 objective boundaries for those of skill in the art.’” *Bell N. Rsch., LLC v. Coolpad  
 28 Techs., Inc.*, 2019 WL 3766688, at \*2 (S.D. Cal. Aug. 9, 2019) (citing *Interval*

1 *Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370-71 (Fed. Cir. 2014)). Had the trial  
 2 been completed in this case, the Court would have had more than sufficient evidence  
 3 to find that the term “small” did not render the claims indefinite.

4 **D. Offer of Proof**

5 “A proper offer of proof informs the trial court of what counsel expects to prove  
 6 by the excluded evidence and preserves the record so that an appellate court can  
 7 review the trial court’s decision for reversible error.” *See Heyne v. Caruso*, 69 F.3d  
 8 1475, 1481 (9th Cir. 1995). In this case while evidence was not actually excluded  
 9 due to the mistrial, the evidence had yet to be presented. Therefore, concurrently with  
 10 this filing, Finjan is presenting the Court with evidence of what the Court would have  
 11 heard had the trial been completed, pursuant to Fed. R. Evid. 103(a).

12 **IV. ARGUMENT**

13 Respectfully, the Court’s Order is incorrect as a matter of law and fact. *First*,  
 14 the Court’s holding was clearly erroneous as a matter of law because it improperly  
 15 shifted the burden to Finjan to prove patent validity. The Court’s Order focused on  
 16 how Finjan “did not provide an explanation as to how that skilled artisan would  
 17 interpret ‘small’ or the context in which it would apply.” (Order at 6.)

18 However, Finjan does not have a burden to prove that the claims are not  
 19 indefinite. As this Court properly held in its October 2019 Order Denying ESET’s  
 20 Motions for Summary Judgment and Motions to Exclude or Strike (Doc. No. 699 at  
 21 6), “ESET has the burden of proving indefiniteness by clear and convincing  
 22 evidence.” (Doc. No. 699 at 6) (citing *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783  
 23 F.3d 1374, 1377 (Fed. Cir. 2015)). Thus, as a matter of law, it is, and always has been  
 24 ESET’s burden to prove by clear and convincing evidence that the “patent’s claims,  
 25 viewed in light of the specification and the prosecution history,” would not “inform  
 26 those skilled in the art about the scope of the invention with reasonable certainty.”  
 27 *Nautilus Inc.*, 572 U.S. at 910. It is not Finjan’s burden to prove the contrary.

28 Notably, ESET’s expert on invalidity, Dr. Spafford, had no difficulty offering

1 an opinion on the scope of the claims for non-infringement and invalidity—though he  
 2 offered no opinion on indefiniteness on the Court’s definition of “downloadable”—  
 3 in his expert reports or deposition testimony. In his expert report on invalidity, Dr.  
 4 Spafford gave multiple examples of his understanding of the application of the  
 5 defined term, “downloadable,” and specifically what “small” meant in light of the  
 6 intrinsic record to a POSITA at the time of the alleged invention. For example, in his  
 7 expert report, Dr. Spafford explained:

8           9         “An applet typically is a **small program** residing on a  
 9 server . . .” (Williams Decl.<sup>3</sup> Exh. 1 (Spafford Inv. Rpt., Ex.  
 10 B-1) at p. 3 (emphasis added).)

11           12         “. . . a computing device (e.g., first computer 210, third  
 12 computer, etc.) can download ‘[a]pplets, which are **small**  
 13 **programs** compiled to an intermediate form.’” (Williams  
 13 Decl. Exh. 2 (Spafford Inv. Rpt., Ex. A-3) at p. 16  
 14 (emphasis added).)

15           16         “... one ordinarily skilled in the art at the time of the alleged  
 16 invention: ‘**a small application program** that can be called  
 17 up for use while working in another application.’”  
 17 (Williams Decl. Exh. 3 (Spafford Inv. Rpt., Ex. D-1) at p.  
 18 13 (emphasis added).)

19           20         “A person of ordinary skill in the art would have understood  
 20 that . . . any form of executable, to Java applications/code  
 21 as specifically referenced, and other form of **small**  
 21 **applications** as well. . . .” (Williams Decl. Exh. 4 (Spafford  
 22 Inv. Rpt., Ex. D-6) at p. 11 (emphasis added).)

23  
 24 Indeed, Dr. Spafford’s opening invalidity report does not even include as an  
 25 alternative analysis that the term “downloadable” as construed is indefinite, rendering

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27           28         <sup>3</sup> All Exhibits (“Exh.”) referenced herein are attached to the accompanying  
 Declaration of K. Nicole Williams.

1 the claims invalid.

2 Moreover, at his March 2019 deposition, Dr. Spafford, testified to his  
3 understanding of what would constitute a downloadable under the Court’s  
4 construction, and at no point during his deposition did he offer that the claim term  
5 was indefinite, much less explain why he thought so. For example, Dr. Spafford  
6 provided explanations as to why specific examples (such as HTML web pages, PDFs,  
7 JavaScript) would constitute a downloadable under the Court’s construction of the  
8 term. (*See* Williams Decl. Exh. 5 (2019-03-13 Spafford Dep.) at 147:10-150:13.)  
9 And, Dr. Spafford presented no testimony at trial, as Finjan’s affirmative presentation  
10 of infringement evidence was interrupted by the mistrial and Defendants’ rebuttal and  
11 affirmative invalidity case had not begun.

12 Further, also due to the mistrial, Finjan’s rebuttal expert, Dr. Michael Goodrich,  
13 did not present his rebuttal opinion regarding validity to rebut Dr. Spafford’s opinions  
14 or confirm the scope of the Court’s definition of “downloadable.” With no trial  
15 testimony from either expert on validity, ESET could not have met its burden to prove  
16 by clear and convincing evidence that the patent claims, viewed in light of the  
17 specification and prosecution history, do not inform those skilled in the art about the  
18 scope of the invention under *Nautilus*. Because the Court’s holding shifted the burden  
19 to Finjan and relied solely on expert testimony from one of Finjan’s experts on  
20 infringement (who was not one of Finjan’s two experts on invalidity), it is clearly  
21 erroneous as a matter of law.

22 **Second**, the Court’s holding is clearly erroneous as a matter of fact when the  
23 Court states that “Finjan **never** offered evidence of a reasonable range for the size of  
24 a small executable or interpretable application program as understood by a skilled  
25 artisan in 1997 based on examples provided in the patent specification.” (Order at 8  
26 (emphasis added).) Finjan was still in its case in chief on infringement when a mistrial  
27 was declared. One of Finjan’s infringement experts, Dr. Michael Mitzenmacher, was  
28 in the middle of his testimony when the trial came to a halt. Another of Finjan’s

infringement experts, Dr. Nenad Medvidovic was waiting to testify about infringement of the remaining patents, and two other Finjan experts, Dr. Trent Jaeger and Dr. Michael Goodrich, were waiting to testify about validity.<sup>4</sup> Had trial continued, Finjan would have offered evidence of what a POSITA would have viewed as a reasonable range for the size of a small executable or interpretable application program. Finjan also would have elicited testimony on cross- examination of ESET’s invalidity expert Dr. Spafford that he *never* opined that the term “small” renders the claims indefinite. This fact alone is significant and was one of the factors the Federal Circuit, in *Sonix*, considered in reversing the district court’s invalidity finding due to indefiniteness. *Sonix*, 844 F.3d at 1390 (“Appellees’ own expert, also did not opine that the claims were indefinite or that a skilled artisan would not have understood the term. . .”).

13 Finjan would have further established during cross-examination that  
14 Dr. Spafford was one of skill in the art and that he understood what the term “small”  
15 meant when viewed in light of the specification and prosecution history, as confirmed  
16 by his infringement and validity opinions relating to the subject limitations. Finjan  
17 would have done this by establishing that Dr. Spafford gave multiple examples in his  
18 expert report of what the term “small” meant in relation to the claims. (*See, e.g.*,  
19 Williams Decl. Exh. 1 (Spafford Inv. Rpt., Ex. B-1) at p. 3; Williams Decl. Exh. 2  
20 (Spafford Inv. Rpt., Ex. A-3) at p. 16; Williams Decl. Exh. 3 (Spafford Inv. Rpt., Ex.  
21 D-1) at p. 13; Williams Decl. Exh. 4, (Spafford Inv. Rpt., Ex. D-6) at p. 11 (emphasis  
22 added).) Finjan also would have cross-examined Dr. Spafford to establish that all the  
23 examples Dr. Spafford identified as meeting the Court’s definition of downloadable  
24 are the same examples that appear in the specifications of the Asserted Patents, *see,*  
25 *e.g.*, ’844 Patent, 1:45-56; ’780 Patent, 1:55-61; ’086 Patent, 2:2-6; ’621 Patent, 3:2-

<sup>4</sup> Finjan's Offer of Proof, filed concurrently with this Motion, provides an overview of what these experts would have testified at trial, but for the mistrial.

1      7; '755 Patent, 2:33-37. Thus, at the conclusion of ESET's case, Finjan would have  
2 moved for JMOL that ESET, the party with the burden of proof, had failed to prove  
3 by clear and convincing evidence that the term "small" rendered the claims indefinite.

4           Had the Court denied the JMOL or taken it under submission, Finjan would  
5 have called, at a minimum, Dr. Goodrich in rebuttal. Dr. Goodrich—who had not  
6 testified at all at the time of the mistrial—would have testified consistent with his  
7 deposition testimony that, while small is a relative term, it will "always be clear from  
8 the context" to one of skill in the art whether something qualifies "as small or not. . ." (Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 101:8-108:14.)<sup>5</sup> Dr. Goodrich, again consistent with his deposition testimony, would have  
11 given specific examples from the prior art:

12           Q. So if one skilled in the art were to pick up a 621 patent  
13 or 755 patent, how would they determine what qualifies as  
14 a downloadable?

15           **A. So the specification of the 962 patent, for example,  
16 gives several examples of this that would be easily  
discernible by a person of ordinary skill in the art.**

17           So, for example, reading from column 1, starting at line 39,  
18 it states, "A downloadable is a **small** executable or  
19 interpretable application program which is downloaded  
from a source computer and run on a destination computer.  
20 **A downloadable is used in a distributed environment,**

---

21  
22           <sup>5</sup> Moreover, both Finjan's and ESET's examples of a "small" downloadable do not  
23 include programs that require installers, consistent with Dr. Cole's testimony at trial.  
24 (See Doc. No. 812-1 (Wells Ex. 2 (Cole Trial Tr.) at 314:5-333:3).) And while Dr.  
25 Cole testified about a narrow question on the physical size of a non-installed  
26 executable, he was not asked whether this was consistent with the claim scope as a  
27 whole, and even noted that such an example was "extremely unusual." (*Id.* (Cole  
28 Trial Tr.) at 464:17-22.)

such as in the Java distributed environment produced by Sun Micro Systems or in the ActiveX distributed environment produced by Microsoft Corporation.”

And so we already see from that and the further readings that occur after that in the specification, that examples of downloadable from the specification itself include Java applets and ActiveX controls. And it even has, like, Figures 4 and 3 that get into the details of the whole architecture surrounding those downloadables.

(Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 104:3-105:1.)

As described above, Finjan would have already established, through the cross-examination of Dr. Spafford, that these examples of “small” executables or interpretable application programs in the prior art are the same examples found in the specifications of the ’844, ’780, ’086, ’621, and ’755 Patents. Drs. Spafford’s and Goodrich’s testimony alone would have raised a triable issue of fact as to whether the term “small” renders the claim term “downloadable” indefinite.

Viewing the testimony that would have been elicited from Dr. Spafford and provided by Dr. Goodrich in the light most favorable to Finjan, the non-moving party, the Court should reconsider its holding, and find that there is a genuine dispute of material fact that precludes summary judgment on indefiniteness, especially where all the evidence was not presented due to the mistrial. *See, e.g., Whitewater W. Indus., Ltd. v. Pac. Surf Designs, Inc.*, 2019 WL 4452986, at \*19 (S.D. Cal. Sept. 16, 2019) (citing *Garter-Bare Co. v. Munsingwear, Inc.*, 650 F.2d 975, 979-82 (9th Cir. 1980) (reversing a district court’s grant of summary judgment where the parties provided conflicting expert testimony, but the district court granted summary judgment by relying solely on one party’s expert testimony)); *see also Sonix*, 844 F.3d at 1381 (“The examiner’s knowing allowance of claims based on the term that is now questioned, plus the acceptance of the term by both parties’ experts, force us to the conclusion that the term ‘visually negligible’ is not indefinite.”).

1       **Third**, the law is clear that simply because a term is relative does not mean it is  
2 indefinite. As described above, in *Sonix*: “[b]ecause language is limited, we have  
3 rejected the proposition that claims involving terms of degree are inherently  
4 indefinite.” *Sonix*, 844 F.3d at 1377 (citing *Interval Licensing*, 766 F.3d at 1370).  
5 Thus, “a patentee need not define his invention with mathematical precision in order  
6 to comply with the definiteness requirement.” *Invitrogen Corp. v. Biocrest Mfg., L.P.*,  
7 424 F.3d 1374, 1384 (Fed. Cir. 2005) (citation omitted). Indeed, “[c]laim language  
8 employing terms of degree has long been found definite where it provided enough  
9 certainty to one of skill in the art when read in the context of the invention.” *Interval*  
10 *Licensing*, 766 F.3d at 1370 (citation omitted). Here, Dr. Goodrich explains that while  
11 context matters given that “small” is a relative term, a POSITA in 1997, would  
12 understand that Java applets or Active X controls would constitute downloadables, in  
13 light of their small size in comparison to the execution environment, such as the  
14 Internet browser. Thus, Dr. Goodrich would have opined on the upper and lower  
15 bounds of the term small in the context of the Court’s claim construction. (*See, e.g.*,  
16 Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 101:8-  
17 108:14); (*see also* Williams Decl. Exh. 5 (2019-03-13 Spafford Dep.) at 147:10-  
18 150:13 (Spafford testimony providing examples of a “downloadable” under the  
19 Court’s construction).)

20       **Fourth**, Finjan anticipates that ESET will argue that the offer of proof  
21 regarding Dr. Goodrich is based solely on his deposition testimony and not his expert  
22 report. However, it is important to note that the indefiniteness argument was not  
23 raised as part of ESET’s invalidity contentions under Patent L.R. 3-3(d), nor was it  
24 raised in ESET’s expert opening report on invalidity, or the Pretrial Order.  
25 Dr. Goodrich’s report was prepared in rebuttal to the opinions in Dr. Spafford’s  
26 invalidity report and, as discussed above, Dr. Spafford’s report was devoid of any  
27 reference to the term “small” rendering the claims indefinite. It was only when asked  
28

1 at his deposition about what he, Dr. Goodrich, thought “small” meant, that  
2 Dr. Goodrich was able to expound upon that issue.

3 **V. CONCLUSION**

4 For the foregoing reasons, Finjan respectfully requests the Court reconsider the  
5 Order and deny ESET’s Renewed Motion for Summary Judgment for Indefiniteness.  
6

7 DATED: April 12, 2021

Respectfully Submitted,

8 By: /s/ Juanita R. Brooks

9 Juanita R. Brooks, brooks@fr.com  
10 Roger A. Denning, denning@fr.com  
11 Jason W. Wolff, wolff@fr.com  
12 Michael A. Amon, amon@fr.com  
13 K. Nicole Williams, nwilliams@fr.com  
14 FISH & RICHARDSON P.C.  
15 12860 El Camino Real, Suite 400  
16 San Diego, CA 92130  
17 Tel: (858) 678-5070  
18 Fax: (858) 678-5099

19 Lawrence Jarvis (*pro hac vice*)  
20 FISH & RICHARDSON P.C.  
21 1180 Peachtree St., NE, 21st Floor  
22 Atlanta, GA 30309  
23 Tel: (404) 891-5005  
24 Fax: (404) 892-5002

25 Attorneys for Plaintiff & Counter-  
26 Defendant Finjan LLC  
27  
28

1

**CERTIFICATE OF SERVICE**

2

The undersigned hereby certifies that a true and correct copy of the above and  
3 foregoing document has been served on April 12, 2021, to all counsel of record who  
4 are deemed to have consented to electronic service via the Court's CM/ECF system  
5 per Civil Local Rule 5.4. Any other counsel of record will be served by electronic  
6 mail, facsimile and/or overnight delivery.

7

8

*/s/ Juanita R. Brooks*

Juanita R. Brooks

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FINJAN LLC'S MPA ISO MOTION FOR RECONSIDERATION  
Case No. 17-cv-0183 CAB (BGS)

## EXHIBIT F

1 Juanita R. Brooks (SBN 75934) brooks@fr.com  
2 Roger A. Denning (SBN 228998) denning@fr.com  
3 Jason W. Wolff (SBN 215819) wolff@fr.com  
4 Michael A. Amon (SBN 226221) amon@fr.com  
5 K. Nicole Williams (SBN 291900) nwilliams@fr.com  
6 FISH & RICHARDSON P.C.  
7 12860 El Camino Real, Suite 400  
8 San Diego, CA 92130  
9 Tel: (858) 678-5070 / Fax: (858) 678-5099

7 Lawrence Jarvis (*pro hac vice*)  
8 FISH & RICHARDSON P.C.  
9 1180 Peachtree St., NE, 21<sup>st</sup> Floor  
Atlanta, GA 30309  
9 Tel: (404) 891-5005 / Fax: (404) 892-5002

10 Attorneys for Plaintiff & Counter-Defendant FINJAN  
11 LLC

12  
13  
14 IN THE UNITED STATES DISTRICT COURT  
15 SOUTHERN DISTRICT OF CALIFORNIA

16 FINJAN LLC,

17 Plaintiffs,

18 v.

19 ESET, LLC and ESET SPOL. S.R.O.,

20 Defendants.

Case No. 17-cv-0183 CAB (BGS)

**FINJAN LLC'S OFFER OF PROOF  
RE OPINIONS OF FINJAN'S  
VALIDITY AND INFRINGEMENT  
EXPERTS**

District Judge: Hon. Cathy Ann  
Bencivengo  
Magistrate Judge: Hon. Bernard G.  
Skomal

25 AND RELATED COUNTERCLAIMS

1       In view of the Court's Amended Order on Defendants' Renewed Motion for  
 2 Summary Judgment (Doc. No. 869), and pursuant to Fed. R. Evid. 103(a)(2), Finjan  
 3 LLC ("Finjan") respectfully submits the following offer of proof in support of  
 4 Finjan's Motion for Reconsideration of the Order on Defendants' Renewed Motion  
 5 for Summary Judgment, filed concurrently herewith. But for the mistrial due to the  
 6 COVID-19 pandemic and the issuance of the State of California's stay-home order  
 7 (Doc. No. 783), Finjan would have called its expert witnesses, including, Drs. Michael  
 8 T. Goodrich, Nenad Medvidovic, and Trent Jaeger to describe how one of skill in the  
 9 art in 1997 would understand the term, "downloadable," and specifically, what is a  
 10 reasonable range for the size of a "small" executable or interpretable application  
 11 program based on examples provided in the patent.

12       1.      Dr. Michael T. Goodrich, Finjan's expert regarding validity of U.S.  
 13 Patent Nos. 9,189,621 ("the '621 Patent"), and 9,219,755 ("the '755 Patent"), would  
 14 testify as to his understanding of "small," in the context of the Court's construction  
 15 for the claim term, "downloadable." (*See, e.g.*, Williams Decl. Exh. 6 (excerpts from  
 16 March 1, 2019 Goodrich Dep.) at 101:8-108:14.)<sup>1</sup> Specifically, Dr. Goodrich would  
 17 testify that "small" is "a relative term, so it depends on the context. So if we're talking  
 18 about a context that is dealing with things that are identified as small as being, let's  
 19 say, on the order of, you know, 5, 10 kilobytes, then something on the order of  
 20 gigabytes would be an example of something that's not small in that context." (*Id.* at  
 21 102:14-22.)

22       2.      Dr. Goodrich would testify, consistent with his March 1, 2019 deposition  
 23 testimony, about examples of a "small" downloadable, in the context of the patents-  
 24 in-suit:

25           Q. And the context you're referring to is the context of 621  
 26 and 755 patents; right?

---

27       1 All Exhibits ("Exh.") referenced herein are attached to the accompanying  
 28 Declaration of K. Nicole Williams.

1  
2 A. Yes. Because, again, small is a relative term. So it also  
3 depends on now what is, you know, a specific instance of,  
4 you know, preferred embodiment, let's say, or looking at  
5 prior art references. That's – that's the way I applied that  
claim language to understand small, and that's relative  
context.

6 Q. Is Internet Explorer a downloadable as considered by the  
7 court?

8 A. Do you have a context for that, like in a prior reference  
9 that you're talking about? Because, again, it's always  
10 relative, so is it -- when you say "Internet Explorer,"  
compared to what?

11 Q. In the context of these patents.

12 A. So it's – it's possible that it could be an executable or not  
13 -- I mean the downloadable or not, depending on what it's  
14 being compared to. Small is a relative term, so you have to  
15 compare it to something. So just in the isolation, one  
16 product could be small or could be large, depending on what  
you're comparing it to.

17 Q. **How does one know if it qualifies as small or not if  
it's a relative term?**

18 A. **Because that will always be clear from the context.** I  
19 mean, if we could talk about any of the prior art references,  
20 and I could tell you, in my opinion, whether or not things  
21 that Dr. Spafford has identified as downloadables qualify as  
22 being small.

23 Q. So if one skilled in the art were to pick up a 621 patent  
24 or 755 patent, how would they determine what qualifies as  
25 a downloadable?

1           A. So the specification of the 962 patent, for example,  
2           gives several examples of this that would be easily  
3           discernible by a person of ordinary skill in the art.

4           So, for example, reading from column 1, starting at line  
5           39, it states, "A downloadable is a small executable or  
6           interpretable application program which is downloaded  
7           from a source computer and run on a destination  
8           computer. A downloadable is used in a distributed  
9           environment, such as in the Java distributed  
10          environment produced by Sun Micro Systems or in the  
11          ActiveX distributed environment produced by  
12          Microsoft Corporation.

13          And so we already see from that and the further  
14          readings that occur after that in the specification, that  
15          examples of downloadable from the specification itself  
16          include Java applets and ActiveX controls. And it even  
17          has, like, Figures 4 and 3 that get into the details of the  
18          whole architecture surrounding those downloadables.

19          Q. With your understanding of what downloadable means  
20          in the context of these patents, would Internet Explorer  
21          qualify as a downloadable?

22          A. Again, it depends on what it's being compared to. So in  
23          this case, the Java applets and ActiveX controls are the  
24          downloadables, and the browser that they would be  
25          executing on is a part of their execution environment. It may  
26          be in some other context, it might make a difference. **But**  
27          **here in this, compared to these little applets and little**  
28          **ActiveX controls, those are the downloadables, not the**  
              **Internet Explorer.** But there might be another context  
              where that would be counted as a downloadable. Depends  
              on a lot of details. It has to fulfill the court's claim  
              construction for what is a downloadable. That's the bottom  
              line.

29          ...

1           **Q. In 1996, what would be considered a downloadable**  
2           **as construed by the court?**

3           ...

4           **A. So the 639 application has examples that are the same**  
5           **examples : Java applets and ActiveX controls. And this**  
6           **is from 1996.**

7           **Q. In 2017, what would be considered a downloadable**  
8           **as construed by the court?**

9           ...

10          **A. In 2017 I would apply the same court's construction**  
11          **namely, a small executable or interpretable application**  
12          **program which is downloaded from a source computer**  
13          **and run on a destination computer. So those same things**  
14          **would still be examples of that, but there may be others**  
             **that would satisfy that claim construction.**

15          (Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at  
16          102:23-107:18 (emphasis added).)

17          3. Dr. Nenad Medvidovic, Finjan's expert regarding infringement of U.S.  
18          Patent Nos. 9,189,621 ("the '621 Patent") and 9,219,755 ("the '755 Patent"), would  
19          testify, consistent with his February 27, 2019 deposition testimony, as to his  
20          understanding of "small" in the context of the Court's construction for the claim term  
21          "downloadable":

22           **Q. Is Internet Explorer a downloadable?**

23           **A. Internet Explorer would fall afoul, at least of the**  
24           **small limitation in the definition, 'cause it's really large.**

25           **Q. Is Microsoft Word a downloadable?**

26           **A. Not in the sense in which this term is construed.**

1

2           **Q. Is Microsoft PowerPoint a downloadable?**

3

4           **A. I -- you know, we can short-circuit this. I don't think**  
5           **that any of the Office products are small so that you**  
6           **could consider them a small executable.**

7

8 (Williams Exh. 7 (excerpts from February 27, 2019 Medvidovic Dep.) at 116:2-11  
9 (emphasis added).)

10

11          4. Dr. Trent Jaeger, Finjan's expert regarding validity of U.S. Patent Nos.  
12 6,804,780 ("the '780 patent"); 8,079,086 ("the '086 Patent"); and 6,154,844 ("the  
13 '844 Patent"), would have testified about his understanding of the term "small"  
14 consistent with his rebuttal expert report where he discusses exemplary instances of  
15 files that are not "small" executables or interpretable application programs, within the  
16 bounds of the Court's construction. This demonstrates that, had Dr. Jaeger had the  
17 opportunity to testify at trial, he would have been prepared to testify on what  
18 constitutes a "small" executable, including opining on the upper and lower bounds of  
19 the term small in the context of the Court's claim construction. For example, Dr.  
20 Jaeger would have testified that "[a] mail database and plain mail files are not  
21 downloadables because they are not 'a small executable or interpretable application  
22 program which is downloaded from a source computer and run on a destination  
23 computer.'" (Williams Decl. Exh. 8 (Jaeger Reb. Rep.) at ¶ 1101.)

24

25          5. In addition, but for the mistrial, Finjan would have cross-examined  
26 Defendants' invalidity expert, Dr. Eugene Spafford. Through cross-examination  
27 Finjan would have demonstrated that Dr. Spafford never opined that the term "small"  
28 rendered the claims indefinite. Finjan would have established that Dr. Spafford had  
given multiple examples of the meaning of the term "small" in the context of the  
Court's claim construction. For example, in addition to his expert report, Dr. Spafford

1 provided his understanding of the term “downloadable,” in the context of the Court’s  
2 construction, during his March 2019 deposition:

3 Q. Do you agree that a Downloadable can be an HTML web  
4 page?

5 **A. So if we go back to Court construction, Court claim**  
6 **construction, a Downloadable is “a small executable or**  
7 **interpretable application program which is downloaded**  
8 **from a source computer and run on a destination**  
9 **computer.” I do not view HTML as an application**  
10 **program.**

11 Q. When you say, “I do not view HTML as an  
12 application program,” are you saying that HTML code  
13 cannot be a Downloadable?

14 ...  
15

16 A. The Court’s construction of an “executable or  
17 interpretable application program”; I do not view an  
18 HTML file, a generic HTML file as an application  
19 program.

20 Q. Can any HTMLs be a Downloadable?

21 A. HTML can be used to transmit JavaScript, Java,  
22 which are executables.

23 Q. So if HTML includes JavaScript, it can be a  
24 Downloadable?

25 A. Those can be Downloadables. Not the HTML, but the  
26 scripts. Those are application programs.

27 Q. So is there any case in which HTML can be a  
28 Downloadable?

A. HTML is a rendering language that describes how to  
display items on the screen. It’s not an application program.

1 So I would not -- I view it as a script but not as an  
2 application program.

3 **Q. So in your opinion, HTML cannot be a**  
4 **Downloadable; correct?**

5 **A. I would not interpret it as such.**

6 **Q. Can Java outputs be a Downloadable?**

7 **A. Yes.**

8  
9 **Q. You stated that JavaScript can be a Downloadable**  
10 **too?**

11 **A. Yes.**

12 **Q. And ActiveX can be a Downloadable too?**

13 **A. Yes. Capital A, capital X.**

14 **Q. Can PDF be a Downloadable?**

15  
16 **A. A PDF file, again, is a display language. PDFs don't**  
17 **- aren't application programs, so I wouldn't see a PDF**  
18 **as an application program.**

19 . . .

20 **Q. Does a PDF with JavaScript qualify as a**  
21 **Downloadable?**

22  
23 **A. As I said, a PDF is a page description form. If it**  
24 **contains JavaScript, the JavaScript can certainly be a**  
**Downloadable.**

25  
26 **Q. So in the case where there's a PDF containing JavaScript,**  
27 **only the JavaScript is considered Downloadable but the**  
28 **PDF is not?**

1 A. That's how I would consider it, given the Court's  
2 instruction.

3 Q This is because PDF does not contain any executable  
4 code; is that correct?

5 A. PDF, yeah, is not an executable.

6 Q. Does PDF include any executable code?

7 A. It may.

8 Q. So if a PDF includes executable code, would that qualify as a  
9 Downloadable?

10 A. It would not be an application program.

11 Q Why is that?

12 A. Because it wouldn't be executed. It may contain an executable  
13 component.

14 (Williams Decl. Exh. 5 (excerpts from March 13, 2019 Spafford Dep.) at 147:10-  
15 150:13 (emphasis added).)

16 6. In sum, had trial not been vacated due to the COVID-19 pandemic,  
17 Finjan would have offered evidence and testimony from the aforementioned  
18 witnesses, consistent with their expert reports and depositions regarding the  
19 reasonable range for the size of a "small" downloadable, from the perspective of one  
20 of skill in the art in 1997, based on examples provided in the patent specifications.  
21  
22

1 DATED: April 12, 2021

Respectfully Submitted,  
2 By: /s/ Juanita R. Brooks

Juanita R. Brooks, brooks@fr.com  
3 Roger A. Denning, denning@fr.com  
4 Jason W. Wolff, wolff@fr.com  
5 Michael A. Amon, amon@fr.com  
6 K. Nicole Williams, nwilliams@fr.com  
7 FISH & RICHARDSON P.C.  
8 12860 El Camino Real, Suite 400  
9 San Diego, CA 92130  
10 Tel: (858) 678-5070  
11 Fax: (858) 678-5099

12 Lawrence Jarvis (*pro hac vice*)  
13 FISH & RICHARDSON P.C.  
14 1180 Peachtree St., NE  
15 21st Floor  
16 Atlanta, GA 30309  
17 Tel: (404) 891-5005  
18 Fax: (404) 892-5002

19 Attorneys for Plaintiff & Counter-  
20 Defendant Finjan LLC

## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 12, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

/s/ Juanita R. Brooks  
Juanita R. Brooks

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability Company,

Plaintiff,

v.

CISCO SYSTEMS, INC., a California Corporation,

Defendant.

Case No. 5:17-cv-00072-BLF

**[PROPOSED] ORDER DENYING CISCO SYSTEM'S, INC.'S MOTION FOR JUDGMENT OF INVALIDITY OF THE '844, '780, AND '494 PATENTS BASED ON COLLATERAL ESTOPPEL**

This matter comes before the Court on Cisco Systems, Inc.'s Motion for Judgment of Invalidity of the '844, '780, and '494 Patents Based on Collateral Estoppel. Upon consideration of all pleadings, papers, and arguments submitted in support and opposition, the Court orders as follows: IT IS HEREBY ORDERED that Cisco's Motion is DENIED.

IT IS SO ORDERED.

Dated: \_\_\_\_\_

Hon. Beth Labson Freeman  
United States District Court

# EXHIBIT C

1 D. Stuart Bartow (CA SBN 233107)  
2 dsbartow@duanemorris.com  
DUANE MORRIS LLP  
3 2475 Hanover Street  
Palo Alto, CA 94304-1194  
4 Telephone: 650.847.4146  
Facsimile: 650.847.4151

5 *Additional attorneys on signature page*

6  
7 Attorneys for Defendant  
CISCO SYSTEMS, INC.

8  
9  
10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA,  
(SAN JOSE DIVISION)

12 FINJAN LLC, a Delaware Limited Liability  
13 Company,

Case No. 5:17-cv-00072-BLF-SVK

14 Plaintiff,

**CISCO SYSTEMS, INC.'S REPLY IN  
SUPPORT OF ITS MOTION FOR  
JUDGMENT OF INVALIDITY OF THE  
'844, '780, AND '494 PATENTS BASED  
ON COLLATERAL ESTOPPEL**

15 v.  
16 CISCO SYSTEMS, INC., a California  
17 Corporation,

18 Defendant.

1 Finjan's Opposition ignores controlling law on the collateral estoppel that results from the  
 2 invalidation of a patent, and instead rests its argument on a recitation of historical facts that are  
 3 legally irrelevant. Once a patent is found invalid, it is dead, and it cannot be asserted against any  
 4 party, regardless of prior claim construction rulings or stipulations in a given case, and regardless  
 5 of whether this Court would have reached the same conclusion on subsidiary issues. The same is  
 6 true of any other patent that presents the identical "issue."

7 Cisco files this reply to make four brief points.

8 First, the only one of the four factors in the collateral estoppel test that Finjan disputes  
 9 regarding any of the three patents is the "final judgment" element, discussed below. Finjan does  
 10 not dispute that under the Federal Circuit case law, the same "issue" exists on the '494 Patent as  
 11 the already-invalidated '844 and '780 Patents, as set forth in Cisco's Opening Brief. *See Ohio*  
 12 *Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013); *Nestlé USA, Inc. v.*  
 13 *Steuben Foods, Inc.*, 884 F.3d 1350, 1351-52 (Fed. Cir. 2018); *Papst Licensing GMBH & Co. v.*  
 14 *Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019); *Arunachalam v. Presidio*  
 15 *Bank*, 801 F. App'x 750, 752-53 (Fed. Cir. 2020). Finjan makes no effort to distinguish the logic  
 16 or outcome of these cases holding that it is the identity of the issues that determines whether  
 17 collateral estoppel applies. Under the governing law, therefore, these patents all must rise (and  
 18 now fall) together.

19 Second, as also set forth in Cisco's Opening brief, it is irrelevant that this Court (and other  
 20 Courts) previously construed the term "Downloadable" (including in the '494 Patent) differently  
 21 than the construction that led to the invalidation of the five patents addressed in the ESET Order.  
 22 The law is again clear that once a patent is found invalid, the only issue for decision in later cases  
 23 is whether the test for collateral estoppel is met. Here, it unquestionably is. Finjan's invitation for  
 24 this Court to blaze a new trail because of Cisco's prior positions in this case is wrong on the law,  
 25 and has been rejected by other district courts. *Quest Integrity USA, LLC v. A.Hak Indus. Servs.*  
 26 *US, LLC*, No. C14-1971-RAJ, 2017 U.S. Dist. LEXIS 119821, at \*10-11 (W.D. Wash. July 31,  
 27 2017); *Crossroads Sys. (Tex.), Inc. v. Dot Hill Sys. Corp.*, 2006 WL 1544621, at \*5 (W.D. Tex.  
 28 May 31, 2006). Cisco laid these cases out in its Opening Brief, and Finjan has no answer.

1       Third, Finjan does not cite any case where a district court declined to apply collateral  
 2 estoppel to the *invalidation* of a patent, where that prior ruling satisfies all four elements of the  
 3 collateral estoppel test. Most of the cases on which Finjan relies for the proposition that a district  
 4 court has the discretion to decline to apply collateral estoppel are not even patent cases, and none  
 5 is a patent case in which a patent has been found invalid. If a district court had the discretion to  
 6 ignore the death of patent in an invalidity ruling, then the Federal Circuit could not have reversed  
 7 the district court's failure to apply collateral estoppel in *Mendenhall*. 26 F.3d 1573 at 1579-80.  
 8 Likewise, Finjan cannot rewrite the decisions in which various district courts followed the law as  
 9 the mere exercise of discretion in which each court coincidentally "chose" to apply collateral  
 10 estoppel. *See* Finjan's Opposition at 5. The more accurate way to describe those decisions is that  
 11 the district courts followed the law, so as to avoid error. And to be clear, Finjan does not cite any  
 12 Federal Circuit case stating that a district court has the discretion to not apply collateral estoppel to  
 13 an *invalidity* ruling where the four-part test for collateral estoppel is satisfied, which would be  
 14 irreconcilable with *Mendenhall*. 26 F.3d 1573 at 1579-80.

15       Finally, Finjan's argument that the ESET Order is not final because it was not "sufficiently  
 16 heard" fails as a matter of law. The ESET Order satisfies the requirement of a "final judgment"  
 17 under Ninth Circuit law, and, the arguments that Finjan will make on appeal and that Finjan is  
 18 making to the ESET Court in its motion for reconsideration are irrelevant. Under Ninth Circuit  
 19 law, a decision is "sufficiently firm" even if not yet ripe for appeal. *Abbott Diabetes Care Inc. v.*  
 20 *Roche Diagnostics Corp.*, C04-02123MJJ, 2007 WL 1239220, at \*12 (N.D. Cal. Apr. 27, 2007).  
 21 The same is true even if there is a pending appeal, in which issues will be considered de novo.  
 22 *Gonzalez v. Tagged, Inc.*, 16-cv-00574-YGR, 2016 WL 3257734, at \*2 (N.D. Cal. June 14, 2016).  
 23 In light of these principles, the pendency of a motion for reconsideration – an "extraordinary  
 24 remedy, to be used sparingly," *Kona Enters., Inc. v. Estate of Bishop*, 229 F.3d 877, 890 (9th Cir.  
 25 2000) – cannot alter the analysis. Indeed, over two weeks after Finjan filed its motion for  
 26 reconsideration, the docket reflects that Judge Bencivengo has not even requested further briefing.  
 27 *Finjan, Inc. v. ESET, LLC*, Case No. 3:17-cv-0183-CAB-BGS.  
 28

1 At a minimum, the patents that all present the “same issue” that is the basis for the ESET  
2 Order – the ‘844 Patent, ‘780 Patent and ‘494 Patent – should be severed and stayed immediately  
3 to avoid forcing Cisco to spend money preparing for trial.

4 Dated: April 29, 2021

5 Respectfully Submitted,

6 DUANE MORRIS LLP

7 By: /s/ Matthew C. Gaudet

8 D. Stuart Bartow (CA SBN 233107)

dsbartow@duanemorris.com

9 2475 Hanover Street

Palo Alto, CA 94304-1194

Telephone: 650.847.4146

Facsimile: 650.847.4151

11 L. Norwood Jameson (admitted *pro hac vice*)

12 Email: wjameson@duanemorris.com

13 Matthew C. Gaudet (admitted *pro hac vice*)

14 Email: mcgaudet@duanemorris.com

15 Robin L. McGrath (admitted *pro hac vice*)

16 Email: rlmgrath@duanemorris.com

17 David C. Dotson (admitted *pro hac vice*)

18 Email: dc-dotson@duanemorris.com

19 John R. Gibson (admitted *pro hac vice*)

20 Email: jrgibson@duanemorris.com

21 Jennifer H. Forte (admitted *pro hac vice*)

22 Email: jhforte@duanemorris.com

23 Alice E. Snedeker (admitted *pro hac vice*)

24 Email: aesnedeker@duanemorris.com

25 1075 Peachtree Street, Ste. 2000

26 Atlanta, GA 30309

27 Telephone: 404.253.6900

28 Facsimile: 404.253.6901

Joseph A. Powers (admitted *pro hac vice*)

Email: japowers@duanemorris.com

Jarrad M. Gunther (admitted *pro hac vice*)

Email: jmgunther@duanemorris.com

30 South 17th Street

Philadelphia, PA 19103

Telephone: 215.979.1000

Facsimile: 215.979.1020

27 Of Counsel

1 John M. Desmarais (CA SBN 320875)  
2 jdesmarais@desmaraissllp.com  
3 Peter C. Magic (CA SBN 278917)  
4 pmagic@desmaraissllp.com  
5 DESMARAIS LLP  
6 101 California Street, Suite 3070  
7 San Francisco, CA 94111  
8 Telephone: 415.573.1900  
9 Facsimile: 415.573.1901

10 Paul A. Bondor (admitted pro hac vice)  
11 pbondor@desmaraissllp.com  
12 Priyanka R. Dev (CA SBN 308363)  
13 pdev@desmaraissllp.com  
14 Joze F. Welsh (admitted pro hac vice)  
15 jwelsh@desmaraissllp.com  
16 DESMARAIS LLP  
17 230 Park Avenue  
18 New York, NY 10009  
19 Telephone: 212.351.3400  
20 Facsimile: 212.351.3401

21 *Attorneys for Defendant*  
22 CISCO SYSTEMS, INC.  
23  
24  
25  
26  
27  
28

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 29, 2021 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Matthew C. Gaudet

Matthew C. Gaudet